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IN THE

Supreme Court of the United States

OCTOBER TERM, 1961

No. 597

RUBBER CORPORATION OF CALIFORNIA,

Petitioner,

vs.

NATIONAL SPONGE CUSHION CO., INC.,

Respondent.

Petition for a Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit.

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To the Honorable Chief Justice and the Associate Justices of the Supreme Court of the United States:

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Circuit Court of Appeals for the Ninth Circuit entered February 8, 1961 (App. p. 1).

Opinions Below.

The memorandum opinion of the trial court will be found at R. Vol 1, p. 34. The opinion of the Circuit Court of Appeals is set forth in the appendix at page 1. It is reported at 286 F. 2d 731.

Jurisdiction.

The judgment of the Circuit Court of Appeals was entered February 8, 1961 (App. p. 1). A petition for rehearing was seasonably filed and denied on March 21, 1961 (App. p. 13). A motion for permission for the District Court to decide on its merits defendant's motion for new trial under Rules 59 and 60 F. R. C. P. was seasonably filed and denied by the Circuit Court of Appeals on September 12, 1961 (App. p. 14).

Jurisdiction of this Court is invoked under Title 28 U. S. C., Sec. 1254(1). The suit arises under the patent laws for patent infringement.

Questions Presented for Review.

(1) Can a Circuit Court of Appeals properly place its own interpretation on what it believes to be inherent in the disclosure of a prior art patent where such interpretation is contrary to such disclosure, and at the same time, refuse defendant an opportunity, under Rules 59 and 60(b)(6), F. R. C. P., to submit physical evidence that the interpretation of the Circuit Court of Appeals is erroneous, as proven by actual practice of the teachings of the prior patent?

(2) Should the benefits of Rules 59 and 60(b)(6) be denied a defendant, who requests a hearing on the merits to prove invalidity of a patent on physical evidence, to rebut plaintiff's unsupported *ex parte* claims after trial and the parallel theory of the Circuit Court of Appeals that plaintiff's patentee's own prior art patent teachings are erroneous and could not result in the product of the patent in suit?

Federal Rules of Civil Procedure Are Involved.

The rules involved in this case are Rule 59 F. R. C. P. and Rule 60(b)(6), the full text of each rule being set forth as follows:

"RULE 59. NEW TRIALS; AMENDMENT OF JUDGMENTS

Text of Rule

"(a) Grounds. A new trial may be granted to all or any of the parties and on all or part of the issues (1) in an action in which there has been a trial by jury, for any of the reasons for which new trials have heretofore been granted in actions at law in the courts of the United States; and (2) in an action tried without a jury, for any of the reasons for which rehearings have heretofore been granted in suits in equity in the courts of the United States. On a motion for a new trial in an action tried without a jury, the court may open the judgment if one has been entered, take additional testimony, amend findings of fact and conclusions of law or make new findings and conclusions, and direct the entry of a new judgment.

"(b) Time for Motion. A motion for a new trial shall be served not later than 10 days after the entry of the judgment.

"(c) Time for Serving Affidavits. When a motion for new trial is based upon affidavits they shall be served with the motion. The opposing party has 10 days after such service within which to serve opposing affidavits, which period may be extended for an additional period not exceeding 20 days either by the court for good cause shown

or by the parties by written stipulation. The court may permit reply affidavits.

"(d) On Initiative of Court. Not later than 10 days after entry of judgment the court of its own initiative may order a new trial for any reason for which it might have granted a new trial on motion of a party, and in the order shall specify the grounds therefor.

"(e) Motion to Alter or Amend a Judgment. A motion to alter or amend the judgment shall be served not later than 10 days after entry of the judgment. As amended Dec. 27, 1946 eff. March 19, 1948."

"RULE 60. RELIEF FROM JUDGMENT OR ORDER

Text of Rule

"(a) Clerical Mistakes. Clerical mistakes in judgments, orders or other parts of the record and errors therein arising from oversight or omission may be corrected by the court at any time of its own initiative or on the motion of any party and after such notice, if any, as the court orders. During the pendency of an appeal, such mistakes may be so corrected before the appeal is docketed in the appellate court, and thereafter while the appeal is pending may be so corrected with leave of the appellate court.

"(b) Mistakes; Inadvertence; Excusable Neglect; Newly Discovered Evidence; Fraud, Etc. On Motion and upon such terms as are just, the court may relieve a party or his legal representative from

a final judgment, order, or proceeding for the following reasons: (1) mistake, inadvertence, surprise, or excusable neglect; (2) newly discovered evidence which by due diligence could not have been discovered in time to move for a new trial under Rule 59(b); (3) fraud (whether heretofore denominated intrinsic or extrinsic), misrepresentation, or other misconduct of an adverse party; (4) the judgment is void; (5) the judgment has been satisfied, released, or discharged, or a prior judgment upon which it is based has been reversed or otherwise vacated, or it is no longer equitable that the judgment should have prospective application; or (6) any other reason justifying relief from the operation of the judgment. The motion shall be made within a reasonable time, and for reasons (1), (2), and (3) not more than one year after the judgment, order, or proceeding was entered or taken. A motion under this subdivision (b) does not affect the finality of a judgment or suspend its operation. This rule does not limit the power of a court to entertain an independent action to relieve a party from a judgment, order, or proceeding, or to grant relief to a defendant not actually personally notified as provided in Title 28, U.S.C. §1655, or to set aside a judgment for fraud upon the court. Writs of coram nobis, coram vobis, audita querela, and bills of review and bills in the nature of a bill of review, are abolished, and the procedure for obtaining any relief from a judgment shall be by motion as prescribed in these rules or by an independent action. As amended Dec. 27, 1946, eff. March 19, 1948; Dec. 29, 1948, eff. Oct. 20, 1949."

Concise Statement of the Case.

This is a patent infringement suit for money damages. It was tried to a jury and the patent held valid and infringed. The District Court granted defendant's motion for judgment notwithstanding the verdict on the basis of the disclosure in a prior art patent and the District Court Judge found the patent invalid for anticipation. Plaintiff's petition to the District Court for rehearing was denied, the petition having been accompanied by affidavits of plaintiff's patentee-employee, who was also a patentee of the prior patent principally relied upon in the decision of invalidity.

The Ninth Circuit Court of Appeals reversed the judgment of the trial court and found the patent valid and infringed, basing its decision on a theory of the inherent result of the prior art teaching which was parallel to the theories presented after judgment in plaintiff's said affidavits. These theories were inconsistent with the teachings of the prior patent.

Defendant's petition for rehearing to the Circuit Court of Appeals was denied without comment (App. p. 13). Defendant's motion to the trial court for new trial under Rules 59 and 60 was denied without ruling on the merits on the ground that the trial court was powerless to act on the merits in view of the decision of the Circuit Court of Appeals. Defendant then unsuccessfully (App. p. 14) moved the Circuit Court of Appeals to grant permission to have the trial court consider on its merits, a motion under Rules 59 and 60(b)(6), F. R. C. P., physical evidence upholding what the trial court found to be the inherent result of the prior art patent teaching, and disproving the theories

presented by plaintiff's *ex parte* affidavits after trial and judgment and the theory of the Circuit Court of Appeals.

Plaintiff opposed the motion on the technical grounds that defendant should have presented earlier the physical evidence of the invalidity of the patent in suit, despite the fact that the issue requiring it was not raised by plaintiff at trial and there had been no earlier need for it.

It is defendant's contention that the unsubstantiated, self-serving *ex parte* affidavits of plaintiff after trial and judgment, which were rejected by the trial court in denying plaintiff's motion for rehearing, influenced the Circuit Court of Appeals in its decision, since plaintiff did not question the prior art patent disclosure at trial. Plaintiffs at trial, presented no evidence supporting plaintiff's late and incompetent criticism of the prior art patent or supplying a basis for the theory of the Circuit Court of Appeals as to the alleged inherent result of the practice of the teachings of the prior art patent.

Since plaintiff strongly relied upon the theories first presented in its post-trial affidavits when the trial court's judgment was appealed, the Circuit Court of Appeals erred, after adopting a theory similar to that of plaintiff's affidavits, in denying to defendant its day in court with the right to be heard on the merits, upon a strong showing, that defendant's physical evidence would prove the correctness of the prior art teaching and its inherent result and thereby invalidate the patent in suit.

Argument.

This case is a suit for patent infringement for damages under the patent laws of the United States and more particularly Title 35, U. S. C., Section 281, and the United States District Court, Southern District of California had jurisdiction under Title 28, U. S. C. Section 1338(a).

The patent in suit, No. 2,740,739, issued April 3, 1956 to Harwin, Stern and Bodle for "Carpet Underlay" (App. p. 15). The patented product is used as a cushion beneath carpeting to provide resiliency and comfort to the step.

It comprises a blown sponge rubber mat having hollow bulges, and secured to an open-mesh fabric, the latter serving to prevent excessive lateral spreading of the hollow bulged sponge under weight.

The patent admits that prior types of carpet underlay include jute pads with or without rubber sprayed thereon, flat sponge rubber pads with or without fabric, flat latex sponge rubber, waffle-type sponge rubber with pre-cemented fabric on one side, and embossed rubber sheets in which resiliency is imparted by the embossments (App. p. 16, Col. 1, lines 20-26).

It is defendant's contention that the primary prior art patent No. 2,480,316 (App. p. 18), issued August 30, 1949 over three years prior to December 27, 1952, the date of the application for the patent in suit, and having as a co-patentee, Virgil H. Bodle, a co-patentee of the patent in suit, if practiced as taught, will inherently result in the production of the product of the patent in suit. The common patentee of the two patents in question has done no more than take the teach-

ings of his prior patent on a process for making carpet underlay and, more than two years later, set forth the teachings of his prior patent in different language including the term "key-lock," an inherent and inescapable result of his own prior art teaching, and claim the product thereof. In the prior art patent the product is disclosed but not claimed.

The jury on June 11, 1958 held the patent in suit valid and infringed [R. Vol. 1, pp. 30, 31]. Defendant's motion for judgment notwithstanding the verdict [R. Vol. 1, p. 32] was upheld by the trial judge and the patent found invalid in a memorandum of decision filed March 31, 1959 [R. Vol. 1, pp. 34-37]. Findings of Fact, Conclusions of Law and Judgment holding the patent invalid were approved by the court and filed April 13, 1959 [R. Vol. 1, pp. 38-45].

A petition for reconsideration of the judgment of the court was filed by plaintiff April 24, 1959 [R. Vol. 1, pp. 46, 47]. This petition was accompanied by the affidavit of said Bodle, a patentee of the patent in suit and of the prior art patent, and an employee of plaintiff [R. Vol. 1, pp. 47-53]. Plaintiff filed a supplemental affidavit by Bodle on May 7, 1959 [R. Vol. 1, pp. 53-55]. These affidavits were unsuccessful in supporting plaintiff's petition. They comprise the first challenge by plaintiff of the clear teachings of the prior art patent and its pertinency as an anticipation of the patent in suit. Plaintiff's petition for reconsideration was denied May 12, 1959 [R. Vol. 1, p. 55]. Upon appeal by plaintiff, the Circuit Court of Appeals reversed the trial judge and found the patent valid and infringed (App. p. 12).

In disagreeing with defendant's contention that by following the teaching of the prior art patent the blowable sponge rubber would inescapably project into and through the open-mesh fabric, thereafter widening and forming the key-lock of plaintiff's claims, the Court of Appeals, on page 4 of its Decision (App. p. 3), stated:

> "On the contrary, the patent (the prior art patent) suggests quite the opposite. It states that the heated rubber 'is soft enough so that it will gravitate into the channels of the shaping drum.' It suggests that a suction pull may be added to that of gravity. The quoted description refers to a pull by gravity or suction precisely opposite to that which is described in plaintiff's patent. This gravitating into the channels of the shaping drum is a process to form the waffle-like ridges or projections, the push or pull being away from and not toward the fabric." (Parenthetical wording supplied.)

Plaintiff's affidavit of Bodle [R. Vol. 1, pp. 47, 48] states:

> "Sponge rubber, if heated by the drum 16 sufficiently to cause it to blow, would be so nearly fluid that the vacuum would suck the almost fluid sponge rubber through the holes 21 into the hollow interior of the drum 16 in the form of rubber threads and such suction or vacuum would certainly break the thin sheet of almost fluid sponge rubber in the channels 23."

Then on the next page [Vol. 1, p. 49], the same affidavit states:

> "What would cause the nearly fluent sponge rubber to fall away from the upper half of the channels 23 as the drum rotates? Gravity."

Other than plaintiff's patentee's affidavit statements, there is nothing in the record of the case to provide a foundation for the theories adopted by the Circuit Court of Appeals.

Plaintiff's affidavits by Bodle [R. Vol. 1, pp. 47 and 53 respectively], beside lacking probative qualifications because of their very nature, are subject to question because the affiant belies the teachings of his own prior patent throughout the affidavits. Some of the statements therein are mere predictions as to what would occur if the prior patent were followed, contrary to what appears on the face of the patent. Even more, Bodle in Vol. 1 of the record, page 50, denies what he swore was part of his invention when he filed his earlier patent application. He states:

> "While it is true that the undersigned executed the application for patent '316, the suggestion of the sponge rubber did not come from either of the inventors named in patent '316; it came from the patent attorney who prepared it."

The prior art patent states:

> ". . . blowable cellular or sponge rubber may be used. . . ." (App. p. 19, Col. 1, lines 39, 40.)

Not only does the prior patent specifically and unmistakably disclose that blowable cellular or sponge rubber may be used but it qualifies the illustration of the product in Figure 1 of the drawings by teaching that cement is not needed to join the rubber and the burlap or open mesh fabric. It states:

> "The backing sheet 12 touches and is secured to the peaks or tops of the embossments or corrugations at one side of the rubber sheet as by a

layer or coating 13 of cement, rubber or the like, *or by being vulcanized directly thereto.*" (App. p. 19, Col. 2, lines 21-26) (emphasis supplied).

With respect to the hollow bulges of the patent in suit and the use of the fabric therein to prevent spreading of the hollow bulged sponge rubber, the prior patent states:

"This backing sheet bridges and closes the open sides of the embossments at one side of the rubber sheet and thereby prevents collapse of the hollow embossments which have their open sides closed by the backing sheet 12." (App. p. 19, Col. 2, lines 26-32.)

Further in the disclosure in the prior patent vulcanization is referred to as follows:

"If desired, the hollow shaping drum may also be heated, in any suitable manner, not shown, but preferably by the injection of steam into the interior chamber 22 of the drum, so as to vulcanize the rubber sheet during the shaping thereof and while the backing sheet is being applied thereto." (App. p. 20, Col. 3, lines 60-66).

* * * * *

"Other ways of heating the drum may be employed for softening the rubber so that it may readily conform to the corrugated periphery of the drum, *and for vulcanization purposes where vulcanization is desired* when the rubber sheet is on the drum." (App. p. 20, Col. 4, lines 1-6.) (Emphasis supplied.)

The patent teaches the use of open-mesh fabric. It states:

> "The flexible backing sheet 12 of suitable textile or other strong and durable preferably *open material*, such as burlap, Osnaburg, or the like, is led from a source of supply 29, between the portions of the rubber sheet 10 and the belt 18, which partially embrace the drum 16, so that the burlap will be carried along with the rubber sheet or strip in contact with the outer closed sides of the ribs 11 of the rubber sheet until the corrugated rubber sheet and the backing sheet thereon are discharged from the apparatus at the point where the guide roller 19' leads the endless belt 18 away from the drum." (App. p. 20, Col. 4, lines 33-45.) (Emphasis supplied.)

The Circuit Court of Appeals has denied to defendant the right to present its motion under Rules 59 and 60 F.R.C.P., and more particularly, Rule 60(b) (6) to the District Court for a new trial to weigh evidence comprising a physical embodiment of the apparatus disclosed in Figure 2 of the prior patent and carpet underlay manufactured in said apparatus by using open-mesh fabric and blowable sponge rubber, wherein the sponge when heated in said apparatus is projected into and through the interstices of the fabric and results in a key-lock and the product of the patent in suit.

Certainly, the actual product resulting from the practice of the prior art patent teachings is more convincing of the inherent result of such prior art patent teaching than the unsupported theories of plaintiff's affiant and of the Circuit Court of Appeals.

The effect of the denial of plaintiff's right to rebut unsupported theories advanced after trial is to create a monopoly on that which previously had been dedicated to the public.

Even if the patentee common to the patent in suit and the prior art patent be acknowledged as an expert in the field, it was not his testimony at trial as an expert upon which plaintiff relies, but upon the unsubstantiated affidavits of that patentee in making a showing rejected by the district court on a motion for reconsideration of the judgment of that court. The Circuit Court of Appeals therefore had no proper expert testimony upon which to rely in its theory conflicting with the clear disclosure of the prior patent.

As the late respected Justice Learned Hand stated in *Kohn v. Eimer*, 265 Fed. 900, 902 in discussing the function of a patent expert,

> "Specifications are written to those skilled in the art, among whom judges are not."

It is respectfully submitted that this is a case where defendant properly should have been given an opportunity to be heard on the merits of its motion. The Second Circuit Court of Appeals in *Sternstein v. "Italia"-Societa per Azioni di Navigazione-Genoa*, 275 F. 2d 502 held:

> "It is clear that a motion for a new trial under Rule 60(b) may be made 'within a reasonable time,' and the delay here was no more than a few days. The trial judge believed the interests of justice required a new trial and the record discloses that there was a proper basis for such belief."

The Ninth Circuit Court of Appeals in *Russell v. Cunningham*, 279 F. 2d 797, held that an order denying a motion under Rule 60(b) is appealable and further held:

> "In addition, there are many cases where appeals from denial of relief under 60(b) have been considered and passed upon without discussing the appealability of the order. The Supreme Court has done so. Ackerman v. United States, 340 U. S. 193 (1950); see Klapprott v. United States, 335 U. S. 601 (1949)."

In *Klapprott v. United States*, 335 U. S. 601, 614, 69 S. Ct. 384, 390, 93 L. Ed. 266, in discussing Rule 60(b)(6) Mr. Justice Black stated:

> "In simple English, the language of the 'other reason' clause, for all reasons except the five particularly specified, vests power in courts adequate to enable them to vacate judgments whenever such action is proper to accomplish justice."

Also in *Klapprott v. United States*, the leading case concerning Rule 60(b)(6), this Honorable Court stated:

> "To accept this contention would therefore introduce needless confusion in the administration of 60(b) and would also circumscribe it within needless and uncertain boundaries. Furthermore 60(b) strongly indicates on its face that courts no longer are to be hemmed in by the uncertain boundaries of these and other common law remedial tools."

The Fifth Circuit Court of Appeals in *Serio v. Badger Mutual Insurance Company*, 266 F. 2d 418,

421 found a delay of nearly seven months after judgment was not an unreasonable time within which to file a motion under Rule 60(b) and stated:

> "The rule is to be liberally construed in order that judgments may reflect the true merits of a case."

Defendant is not requesting this Honorable Court to decide the merits of defendant's motion under Rules 59 and 60(b)(6) F.R.C.P. It is only petitioning for a decision as to whether the trial court should have the opportunity which the Circuit Court of Appeals has denied, to pass upon the merits of defendant's motion.

The Third Circuit Court of Appeals in *Federal Deposit Insurance Corp. v. Alker,* 223 F. 2d 262, 263 stated:

> "The judgment of the district court in this case was affirmed by this court on November 7, 1945, 151 F. 2d 907. Since that time defendant Alker has made repeated efforts in the district court, in this court and in the Supreme Court to obtain relief from the judgment by way of a new trial. This court is now again presented by Alker with a motion for an order granting leave to the district court to reconsider his motion for a new trial. We are constrained at this time to grant the leave requested even though we have denied similar applications in the past. We do so because we have now reached the conclusion that Alker should have an opportunity to convince the district court, if he can, that he is entitled under Rule 60(b) of the Federal Rules of Civil Procedure, 28 U. S. C.

to relief from the judgment entered against him by that court. *In reaching this conclusion we make it clear that we intimate no opinion upon the merits of Alker's motion for a new trial or even whether the district court is empowered to grant it under Rule 60(b). We merely desire to open the way for the district court to decide those questions, which it will do in the exercise of its own responsibility and discretion.* We will, of course, also vacate the writs of prohibition and mandamus heretofore directed to the district court at our No. 10,948, 206 F. 2d 299)." (Emphasis supplied.)

Conclusion.

(1) The Circuit Court of Appeals erred in adopting an interpretation as to what was inherent in the disclosure of the prior art patent contrary to the express terms of such disclosure, and on the basis of such interpretation, refusing defendant an opportunity under Rules 59 and 60(b)(6) F.R.C.P. to submit evidence that such interpretation is erroneous, based upon actual practice of the teachings of the prior patent.

(2) The Circuit Court of Appeals erred in denying the benefits of Rule 59 and or 60(b)(6) F.R.C.P. to defendant who requested a hearing on the merits to prove invalidity of the patent in suit on physical evidence rebutting plaintiff's unsupported ex parte claims after trial, and also rebutting the theory of the Circuit Court of Appeals parallel to that of plaintiff's claims to the effect that plaintiff's patentee's own prior art

patent teachings are erroneous and could not result in the product of the patent in suit.

You are accordingly respectfully petitioned to issue a Writ of Certiorari as the questions involved herein are of importance not only to this petitioner but to the public and should be determined by this Court.

Respectfully submitted,

ALLAN D. MOCKABEE,
Attorney for Petitioner.

APPENDIX.

Opinion of the United States Court of Appeals for the Ninth Circuit.

United States Court of Appeals for the Ninth Circuit.

National Sponge Cushion Co., Inc., a corporation, Appellant, vs. Rubber Corporation of California, Appellee. No. 16,562.

Filed Feb. 8, 1961.

Appeal from the United States District Court for the Southern District of California, Central Division.

Before Stephens, Pope and Jertberg, Circuit Judges.

Pope, Circuit Judge.

The appellant, owner of Harwin Patent No. 2,740,737, for Carpet Underlay, brought this action against the appellee charging infringement of its patent and seeking damages therefor. After issued joined, the case was tried to a jury which returned a verdict for the plaintiff. Thereafter the court granted defendant's motion for judgment notwithstanding the verdict under Rule 50(b) of Federal Rules of Civil Procedure, and entered judgment accordingly for the defendant.

The action of the court was based upon the findings of the trial judge that the claimed patent lacked novelty because of anticipation of its claims by developments in the prior art. By this appeal the plaintiff challenges the propriety of the court's rejection of the contrary finding of the jury and its own finding of anticipation.

Plaintiff's patent relates to a type of product which is used to underlay, anchor and cushion floor carpets. In this general area of product, such carpet underlays are useful in cushioning the carpet and making it more

resilient. For this reason the main constituent of the underlay is made of rubber, usually foam rubber, because of its cushioning effect. The rubber serves to anchor the carpet and prevent slipping along the floor.

Such devices are usually completed by attaching to the upper surface of the rubber pad which lies next to the floor a fabric material sealed or bonded in some manner to the rubber pad. Prior to plaintiff's product, this was done by using a cement to join the fabric to the rubber. This fabric serves two purposes: It furnishes a fairly flat surface on which the carpet may lie and it holds firmly in place the rubber pad to which it is affixed preventing it from spreading by lengthening or widening as a result of use, as it might otherwise do. Some of these carpet underlays are made of foam rubber formed in corrugations so as to facilitate air reaching all parts of the pad and thus aiding in retention of its resiliency. When the rubber pad is formed in that manner the anti-spreading action of the attached fabric is particularly useful as a corrugated rubber pad is more likely to spread apart than would be the case with a solid rubber one.

Plaintiff's claimed invention, as the stated claims disclose, relates solely to the manner in which the fabric portion of the underlay is attached and fastened to the rubber which lies beneath it. The patented structure discloses that the coarse fabric, with interstices approximately one-sixteenth of an inch square, has been bonded to the rubber through the fact that the rubber has been caused to penetrate the interstices of the fabric so that after passing through such openings the penetrated rubber has spread out and formed protrusions with knob-like heads larger than the interstices. The result

is a key-locked connection between the fabrics and the sponge rubber which has been accomplished without the use of any adhesive.

In further explanation of the structure, the specifications state that this key-locking mode of attachment of the fabric to the rubber pad with its waffle-like corrugations is accomplished by heating and blowing the sheet of sponge rubber into a corrugated mold whereby the rubber is held in intimate contact with the fabric so that in blowing or expanding, the rubber is forced to enter the interstices of the fabric and swell around adjacent threads of the fabric and form the headed knob-like projections that are somewhat larger in size than the areas of the fabric interstices. The claims as stated appear in the margin.[1]

In this case, as in many other cases where a claimed invention is attacked on the ground that the claims of patented devices were anticipated by earlier patents, the

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[1] "1. A carpet underlay comprising a coarse-mesh fabric, and a sponge rubber facing on one side of said fabric and formed with bulges that are spaced from the fabric, said facing between the bulges, being in contact with the fabric and having a multiplicity of projections formed and forced by pressure from a blowing agent and extending into and through the interstices of the fabric.

"2. A carpet underlay according to claim 1: the portions of said projections that extend through the interstices of the fabric being larger than said interstices to effect a key-locking engagement of the fabric and the sponge rubber.

"3. A carpet underlay comprising a coarse-mesh fabric, a sponge rubber facing on one side of said fabric and formed with bulges that are spaced from the fabric, said facing, between the bulges, being in contact with the fabric, a multiplicity of integral projections on the bulges and extending through the interstices of the fabric to bond the bulges of the facing and the fabric, the latter being generally flat.

"4. In a carpet underlay according to claim 3: the projections being disposed along space parallel lines that are on a bias relative to the weave of the fabric."

decision as to validity may turn upon a question of fact. Leishman v. General Motors Corp., 9 Cir., 191 F. 2d 522, 529. (See other cases cited in Bergman v. Aluminum Lock Shingle Corp. of America, 251 F. 2d 801, 809-813, concurring opinion.) Our first inquiry necessarily is: what was the prior art as disclosed by the prior patents which were part of the record in this case? The question is whether insofar as this factor entered into the verdict of the jury, the evidence of anticipation was so overwhelming and compelling that it can be said that as a matter of law there was a total failure of proof of the essential novelty to sustain the plaintiff's case so that the district court was justified in granting judgment notwithstanding the verdict.

The Judge's conclusion, as disclosed by his memorandum of decision, was based upon his views of two prior patents, Blair and Bodle, No. 2,480,316, and Coyte, No. 562,281. This he stated in the memorandum as follows: "The Patent in suit does not disclose invention in the light of the teaching of Blair and Bodle United States Letters Patent No. 2,480,316, particularly in view of Coyte, United States Letters Patent No. 562,281." So far as those two patents are concerned, we have no difficulty in arriving at a conclusion that neither one of them was of such character as to establish anticipation. As we have said, the novelty claimed for the patent here in suit relates to the manner of key-locking or bonding the woven fabric to the rubber pad; the Blair and Bodle patent was a process patent stated to be for a method of making laminated cushion material. That patent described a product made of a sheet or lamination of rubber which might be shaped or formed into corrugations or hollow ribs

which had applied to it a backing sheet of material such as burlap to reinforce the rubber material. However, the method of attachment of the backing sheet is there described as follows: "The backing sheet 12 touches and is secured to the peaks or tops of the embossments or corrugations at one side of the rubber sheet as by a layer or coating 13 of cement, rubber or the like, or by being vulcanized directly thereto."[2]

Another prior patent relied on by the trial court as an anticipation has even less resemblance to the claimed patentable feature of the patent here in suit. Claims 1 and 2 of the plaintiff's patent described a project which has rubber "formed and forced by pressure from a blowing agent and extending *into and through* the interstices of the fabric." (Emphasis added.) The portions of the projections that extend through the interstices of the fabric are described as "being larger than said interstices to effect a keylocking engagement of the fabric and sponge rubber." Coyte contains nothing which remotely resembles this.

The Coyte process if for the purpose of making gutta-percha cloth. The process involves the passing

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[2]Appellee suggests that since this patent contemplated the use of blowable cellular or sponge rubber, that the blowable sponge rubber would project into and through the open mesh fabric thereafter widening and forming the key-lock referred to in plaintiff's claims. There is no evidence to support such a contention, and nothing in the Blair-Bodle patent to suggest that any such thing was contemplated. On the contrary, the patent suggests quite the opposite. It states that the heated rubber "is soft enough so that it will gravitate into the channels of the shaping drum." It suggests that a suction pull may be added to that of gravity. The quoted description refers to a pull by gravity or suction precisely opposite to that which is described in plaintiff's patent. This gravitating into the channels of the shaping drum is a process to form the waffle-like ridges or projections, the push or pull being away from and not toward the fabric.

of a sheet of gutta-percha with a cloth or fabric laid upon it between heated rolls, firmly pressed together, so that portions of the gutta-percha sheet will "project into the meshes of the fabric" and "cause the gutta-percha to be held to the fabric."

It would appear to be obvious that this proces. could not possibly cause the gutta-percha to extend "through" the interstices of the fabric or to accomplish an attachment by a key-locking process.

If all that this record contained with respect to anticipation of the patent in suit were the two patents we have just discussed, namely, Blair and Bodle, and Coyte, it would be hard to say that there was sufficient evidence even to permit a submission of that question to a jury. With that alone in the record it could well be said that no valid challenge of the novelty of plaintiff's device had been presented. But there is in the record another patent not alluded to by the court in its findings or opinion which in our view does present a question of fact with respect to anticipation, although a question which we think it was proper for the jury to decide.

That patent is Alderfer No. 2,048,619. It discloses an undertaking by the inventor to produce a very different product having very different qualities than that contemplated by the patent in suit. That patent was for what was called a "fabric coated sponge rubber and method of making same." The indicated objectives related solely to the procuring of desirable surfaces both on the rubber and on the fabric. The patent undertook to disclose a novel product where the "outer surface of the foam rubber is smooth, planished and porous having uniformly distributed microscopic pores."

For the fabric side of the product the object was to see to it that "the fabric be a knitted textile fabric, rather than woven, to increase the softness and enhance the appearance of the fabric side of the product." As illustrations of the use of the product the inventor stated "automobile seat coverings foam rubber backed with finely knitted fabric presents a softer texture and a more pleasing appearance than can be obtained with a woven textile fabric. Also, foam rubber backed with knitted textile fabric such as tricot is desired in making certain products such as brassieres, because of the soft sheen and delicate appearance of the fabric."

For his means of accomplishing these surface objectives the inventor introduced between the layer of the sponge rubber and the knitted fabric "an intermediate layer of square mesh fabric which was substantially non-elastic." To put this product together he spread freshly foamed latex upon a smooth surface which traveled in one direction under a doctor roll or doctor bar which was adjusted to give the latex the desired depth or thickness. The two fabrics, the woven and the knitted, were then carried under the doctor bar so that the open mesh woven fabric was in direct contact with the top surface of the reduced layer of foam latex and the knitted fabric was introduced on top of the woven fabric. The specification stated that by this process "the foamed latex will pass or 'strike' through the open meshes (of the woven fabric) into contact with the inner surface of the knitted fabric layer which also absorbs some of the water in the latex to cause the latex to firmly embed itself in the interstices of the knitted fabric and become securely anchored to the fabric layer."

Plainly enough this discloses a product and a process where foam latex passed through a woven fabric and embedded itself in the interstices of the knitted fabric. It appears to us that the passing of heated sponge rubber through a woven fabric does not in itself anticipate a key locking device such as that of the patent in suit. In Alderfer the passing of the latex through the interstices is described, but it simply passes through and into interstices of knit fabric which is shown in the Alderfer drawings as being of substantial thickness as in all knit fabrics. There is no suggestion whatever of a bonding by key-lock as in the patent before us.[3]

In describing his product the inventor of plaintiff's device set forth how the key locking knobs were formed. When the uncured sponge rubber sheet comes from the rubber mill it is placed on a traveling mold and the net fabric is placed thereover. A web is placed over the fabric and another beneath the mold. This five-ply assembly is then moved slowly between heated platens, fixedly spaced without pressure. The heat causes the sponge rubber sheet to expand and since the rubber is held in intimate contact with the fabric, the expansion forces the rubber to enter the interstices and "swell around adjacent threads of said fabric to form headed knob-like projections that are somewhat larger in size than the areas of the fabric interstices."

We are of the opinion that on the evidence here the jury were justified in finding as a fact that the product

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[3]Nothing in Alderfer suggests that the inventor intended or appreciated any key-locking development from the passage of the latex through the woven fabric. "It is well settled that prior accidental production of the same thing, where character and function are not recognized, does not anticipate." McKee v. Graton & Knight Co., 4 cir., 87 F. 2d 262, 264, and cases there cited. Walker on Patents, Deller's Edition, §57.

thus produced had a novelty not anticipated by anything shown in Alderfer. Its verdict should not have been set aside.

One thing that confirms us in this view is that the portion of the patent office file received in evidence discloses that Alderfer was cited in connection with the application for plaintiff's patent and that this problem of anticipation by Alderfer was considered and a resolution of the matter arrived at only after considerable controversy and an amendment of the claims originally presented.[4]

As noted in S. H. Kress & Co. v. Aghnides, 4 Cir., 246 F. 2d 718, the usual presumption of validity of a patent (Mumm v. Decker & Sons, 301 U. S. 168, Patterson-Ballagh Corp. v. Moss, 9 Cir., 201 F. 2d 403, 406), may be strengthened by the history of the patent in the patent office, particularly when it has been granted only after considerable controversy.

This brings us to the question whether the new improvement disclosed in the patent in suit measures up to the established standards for invention. This is a question of law. Bergman v. Aluminum Lock Shingle

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[4]An original claim "6" was rejected, it being stated by the Examiner "In Alderfer the fabric 10 is considered to have the interstices through which the rubber extends and fastens itself as claimed." Claim 6 to which this referred read as follows: "In a carpet underlay comprising a coarse-mesh fabric and a sponge rubber facing thereon, a multiplicity of headed projections integral with the facing and extending from the facing through the interstices of the fabric with the heads thereof on the side of the fabric opposite to the facing." This claim was then amended to read as in Claim 3 of the patent. (footnote 1, supra.).

It will be noted that in the amended claim the product is described not merely as one involving projections through the fabric, but with one having "projections on the bulges" and extending through the interstices "to bond the bulges of the facing and the fabric." So amended the claim No. 3 was allowed.

Corp. of America, supra, which requires a discussion of whether the device here shown required more ingenuity than the work of a mechanic skilled in the art. Cuno Corp. v. Automatic Devices Corp., 314 U. S. 84, 90; Leishman v. General Motors Corp., 9 Cir., 191 F. 2d 522, 530; 35 U. S. C. §103.

The record here shows that leading up to the development of the product here in question was a long period of study, effort and experiment in an attempt to produce a practical means of attaching fabric to sponge rubber without the use of cement, which was the previously accepted method of attachment. The cementing process added approximately 10% to the cost of such a product. The device had commercial success; beginning with gross sales of $350,000 in 1951 they increased in three years to $2,370,000. All of these things, though not controlling, are indicia of actual invention and properly considered in determining that question. It is of no significance that "viewed after the event, the means . . . adopted seem simple and such as should have been obvious to those who worked in the field, but this is not enough to negative invention." Goodyear Co. v. Ray-O-Vac. Co., 321 U. S. 275, 279. "Now that it has succeeded, it may seem very plain to any one that he could have done it as well. This is often the case with inventions of the greatest merit." Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403, 446. See Patterson-Ballach Corp. v. Moss, supra.

It is inferable from the facts in this case, including the rapid success which the new product found in the market, that this development for the first time, of a key-lock bond system for attaching the rubber to the

fabric, was not only highly useful and a significant improvement over former products which utilized cement for attachment, but that it measured up to the established standards required for invention.

The trial court, without dealing in any specific manner with the question of the development of a key-locking engagement between the fabric and sponge rubber so as to bond the same, complained that plaintiff's evidence too much emphasized the method and apparatus used in the construction of the project. It is true that the specifications include a description of the manner and process of making and using the invention; but the precise structure of the patent is also described with clarity and the drawings referred to in the specifications, particularly Figures 2 and 3, adequately disclose the nature of the claims. The addition to the specifications of a description of the manner in which the carpet underlay described may be made, merely adds to the other description but in no manner invalidates the patent.[5] Furthermore, the claims adequately and sufficiently covered and described the improvement regarded as the invention.[6]

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[6]In Winslow Engineering Co. v. Smith, 223 F. 2d 438, this court, following Graver Tank & Mfg. Co. v. Linde Air Products Co., 336 U.S. 271, although it found invention, held a patent invalid for insufficiency of the statements in the claims and that the deficiency could not be supplied by reference to the specifications. A similar point has not been raised in this case; but it is plain that the claims here are stated adequately to meet the requirements in the Graver Tank case, supra. Apparently in Bergman v. Aluminum Lock, supra, this court overlooked the rule of the Graver case and its own decision in the Winslow case.

[5]Trusell Mfg. Co. v. Wilson-Jones Co., 2d cir., 89 F. 2d 1027, 1029: "But, if the article is new, it may be patented, and the claim will not be invalidated merely because it describes the article with some reference to the method of producing it." See 35 U.S.C. §112.

We hold that the patent was valid.

With respect to the question of infringement, little need be said. A mere examination of the exhibits disclosing the patented article produced pursuant to plaintiff's patent and the accused device adequately demonstrates the claimed infringement. In setting aside the verdict the court below did not purport to find any fault with the jury's finding of infringement. It would be impossible to do so.

The judgment is reversed and the cause is remanded for further proceedings not inconsistent with this opinion

(Endorsed) Opinion Filed Feb. 8, 1961.

Frank H. Schmid, Clerk.

Judgment.

Office of the Clerk
U. S. Court of Appeals
P. O. Box 547
San Francisco 1, Calif.

March 21, 1961

Allan D. Mockabee, Esq. Attorney-at-law.
108 West 6th Street,
Los Angeles 14, Calif.

Dear Sir:

The Petition for a Rehearing heretofore filed in case No. 16562—Nat'l Sponge Cushion Co. v. Rubber Corporation of California, was this day denied.

Pursuant to Rule 26, and unless stayed by the order of the Court, a mandate of this Court under said Rule will be due to issue on the expiration of five (5) days from the date hereof.

Very Truly yours,

FRANK H. SCHMID, Clerk.

Memorandum Opinion.

United States Court of Appeals, for the Ninth Circuit.

National Sponge Cushion Co., Inc., Plaintiff-Appellant, v. Rubber Corporation of California, Defendant-Appellees. No. 16562.

Filed, Sept. 12, 1961.

Before Pope, Jertberg and Merrill, Circuit Judges.

Appellee's motion for an order that the trial court for the Southern District of California be permitted to decide on their merits Motions under Rules 59 and 60, Federal Rules of Civil Procedure, is denied.

Walter L. Pope,
Gilbert H. Jertberg,
Charles M. Merrill,
United States Circuit Judges

April 3, 1956 D. R. HARWIN ET AL 2,740,739

CARPET UNDERLAY

Filed Dec. 27, 1952

Fig. 1.

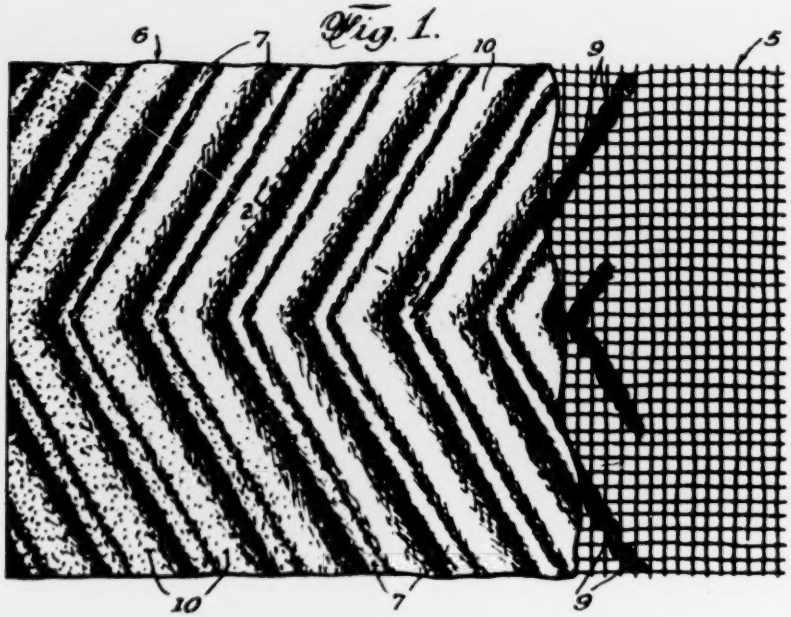

Fig. 2.

Fig. 4.

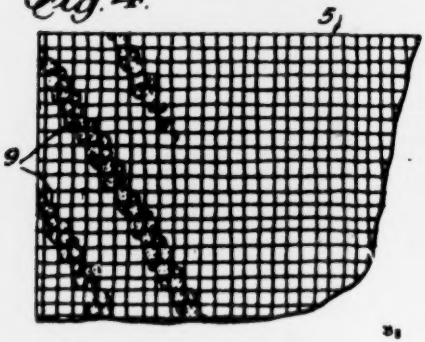

Fig. 3.

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United States Patent Office

2,740,739

Patented Apr. 3, 1956

2,740,739

CARPET UNDERLAY

Dixon R. Harwin, Alfred Stern, and Virgil H. Bodle, Los Angeles County, Calif., assignors to National Sponge Cushion Co., Inc., Los Angeles, Calif., a corporation of California

Application December 27, 1952, Serial No. 328,186

4 Claims. (Cl. 154—49)

This invention relates to a carpet underlay or pad and, while more particularly adapted for use as an underlay to cushion carpets and rugs, the same is also adapted to be used as upholstering material, in the production of mattresses, padding for various purposes, cushions, etc.

Prior types of carpet underlay include jute pads with or without rubber sprayed thereon, similar pads made of cattle hair or a combination of cattle hair and jute, flat sponge rubber pads with or without fabric, flat latex sponge rubber, waffle-type sponge rubber with pre-cemented fabric on one side, embossed rubber sheets in which resiliency is imparted by the embossments, etc. The effectiveness as carpet underlay of these prior materials varied, some having desirable properties as well as those not to be desired. For instance, the fibrous pads were subject to mildew and/or becoming moth eaten and also caused allergic discomfort to certain people; the flat sponge rubber pads, besides being quite expensive if formed of suitable thickness to be properly resilient, were too heavy and therefor difficult to handle, solid embossed rubber pads were also costly and heavy and, in addition, lacked porosity enabling drawing dust and dirt through them; etc.

Recognizing the different faults inherent in prior materials, it is an object of the present invention to provide carpet underlay that is shock-cushioning, long-wearing, comfortable in use, resists rug or carpet slippage, does not cause allergic reactions, eliminates damage by moths, mildew, etc., is easily handled, and, generally, is free of the different faults of prior underlay pads.

The present invention contemplates the provision of a carpet underlay comprised only of a large-mesh fabric backing and sponge rubber applied to and affixed to said fabric backing without adhesive, the rubber being so formed, during blowing and vulcanizing, that the same swells into a series of porous bulges and simultaneously effects key-locking engagement with the fabric by penetrating the interstices of the fabric to form knob-like heads larger than said interstices. It is another object of the invention to provide carpet underlay characterized by a key-locked connection of a fabric backing and sponge rubber substantially as defined above.

In order to improve the carpet-gripping properties of the underlay herein contemplated, it is a further object of the invention to form the sponge rubber bulges as a series of semi-tubular forms that are diagonally directed first in one direction and then in the other, alternately

A still further object of the invention is to provide a carpet underlay, as above indicated, in which the semi-tubular forms of sponge rubber extend at an angle to the warp and weft of the fabric backing, whereby the mentioned key-locking heads of said rubber are more evenly distributed over the length and width of the fabric so that every warp and weft thread of the fabric has several points of interlocking engagement with the sponge rubber.

The invention also comprises novel details of construction and novel combinations and arrangements of parts, which will more fully appear in the course of the following description. However, the drawing merely shows and the following description merely describes one embodiment of the present invention which is given by way of illustration or example only.

In the drawing, like reference characters designate similar parts in the several views.

Fig. 1 is a top plan view of a relatively small portion of carpet underlay according to the present invention, a fragment of the sponge rubber thereof being removed to show, in cross-section, the interlock between said rubber and the fabric backing of the underlay.

Fig. 2 is a considerably enlarged fragmentary cross-sectional view as taken on line 2—2 of Fig. 1.

Fig. 3 is a further enlarged fragmentary cross-sectional detail view of a portion of Fig. 2 and particularly showing the interlocking feature of the underlay.

Fig. 4 is a fragmentary bottom plan view of the underlay showing the key-locking portions of the sponge rubber that penetrate the interstices of the fabric backing.

Referring now to the drawing, the present carpet pad or underlay comprises, generally, a fabric backing 5 and a top facing 6 of sponge rubber bonded to said backing in a manner and by means hereinafter described.

The fabric backing 5 is preferably in the form of a coarse-mesh material that may be termed net, since the interstices of the same are large relative to the thickness of the thread or yarn from which the fabric is woven. In the usual way, this net fabric has warp and weft threads that are, respectively, longitudinal and transverse to the length of the fabric to, thereby, eliminate longitudinal and transverse stretch of the fabric

The fabric threads may be jute or a comparable material which, in practice, are woven to provide a mesh having about fourteen threads per inch. The thread count may vary, providing the interstices of the fabric are large enough to permit ample penetration of the sponge rubber therethrough.

With regard to the sponge rubber used to form top facing 6, it is deemed unnecessary to detail all of the different ingredients contained therein when initially compounded. For the purposes of this invention, it can be stated that the uncured rubber is compounded from raw rubber as it comes from the bale (the same being first softened, as by heat or in other ways), a blowing agent, accelerators, softening anti-oxidant, filler and sulphur.

Ordinary sponge rubber is compounded with a blowing agent, such as soda bicarbonate or sodium carbonate, or other like blowing agents, activated with various acids, such as stearic, oleic or acetic acid, in such manner that, under heat, the blowing of the sponge will take place first and vulcanization later. In order to enable the gases generated by the vulcanizing and blowing heat to more fully expand and seal, the present invention contemplates simultaneous or substantially simultaneous blowing and vulcanization by providing an excess of accelerator over the amount commonly used, and also a considerably larger amount of sulphur than is commonly used. In the present instance, at least 2% and as much as 3% of accelerator and 3.75% to 4% of sulphur in the rubber compound are used under heat ranging between 300° and 370° F. to obtain substantially simultaneous blowing and vulcanization of the sponge rubber.

In practice, a combination of what is known in the trade as Captax, Altax, Ledate and Aktone comprises the accelerator, the urea in Aktone causing uniform cells or

pores in the sponge and also inducing slight vulcanization before blowing and full vulcanization occurs.

The crude rubber, compounded as above, is mixed in a Banbury machine to break the "nerve" of the crude rubber and obtain thorough homogeneity among the ingredients. The compound is then rolled out into a sheet about .050" thick in a conventional rubber mill. Of course, a coloring agent may be introduced in the compound if desired.

To form a carpet underlay according to the invention, the uncured sponge rubber sheet, as it comes from the rubber mill, is placed on a travelling mold and the net fabric 5 is placed thereover. A web is placed over the fabric and another beneath the mold. This five-ply assembly is then moved slowly between chests or platens heated to between 300° and 370° F. No pressure is applied, the heated platens being fixedly spaced.

The gases generated in the sponge rubber sheet cause expansion of said sheet to a thickness some ten times greater than the initial .050" thickness, except where the sheet is confined by the mold. At such points, indicated at 7, the rubber is held in intimate contact with fabric 5 and, in blowing or expanding, the rubber is forced to enter the interstices of the fabric, as best seen in Fig. 3, and swell around adjacent threads 8 of said fabric to form headed knob-like projections 9 that are somewhat larger in size than the areas of the fabric interstices. The web on that side limits such rising of the rubber so that the headed projections 9 are generally flattened, as shown. Thus, wherever the mold prevents expansion away from fabric 5, the rubber expands in the opposite direction through said fabric.

Between the points of engagement 7 of the rubber and the mold, as the rubber blows, the same expands into the mold cavities. Such expanding portions are shown at 10 and, in this instance, the same are in the form of semi-tubular portions that alternate with the points or areas 7. It is immaterial what the shape of the mold cavities is, providing the depth of the same is sufficient to accommodate the expanding rubber as it blows. The semi-tubular form shown is preferred because the same affords channels or passages 11 that permit free escape of the released gases. Also, because the semi-tubular forms can be arranged on a bias or diagonal to the weave of fabric 5, an efficient distribution of the projections 9 is afforded and the diagonal direction may be alternately changed to improve the carpet-gripping properties of the underlay.

Because of the porous nature of the sponge rubber and also because areas 7 are quite thin, the underlay thus produced can be kept clean by ordinary vacuum cleaners while such cleaners are vacuuming the rug or carpet overlaying the same.

While we have illustrated and described what we now contemplate to be the best mode of carrying out our invention, the construction is, of course, subject to modification without departing from the spirit and scope of the invention. It is, therefore, not desired to restrict the invention to the particular form of construction illustrated and described, but to cover all modifications that may fall within the scope of the appended claims.

Having thus described the invention, what we claim and desire to be secured by Letters Patent is:

1. A carpet underlay comprising a coarse-mesh fabric, and a sponge rubber facing on one side of said fabric and formed with bulges that are spaced from the fabric, said facing between the bulges, being in contact with the fabric and having a multiplicity of projections formed and forced by pressure from a blowing agent and extending into and through the interstices of the fabric.

2. A carpet underlay according to claim 1; the portions of said projections that extend through the interstices of the fabric being larger than said interstices to effect a key-locking engagement of the fabric and sponge rubber.

3. A carpet underlay comprising a coarse-mesh fabric, a sponge rubber facing on one side of said fabric and formed with bulges that are spaced from the fabric, said facing, between the bulges, being in contact with the fabric, a multiplicity of integral projections on the bulges and extending through the interstices of the fabric to bond the bulges of the facing and the fabric, the latter being generally flat.

4. In a carpet underlay according to claim 3; the projections being disposed along spaced parallel lines that are on a bias relative to the weave of the fabric.

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Aug. 30, 1949. G. W. BLAIR ET AL 2,480,316

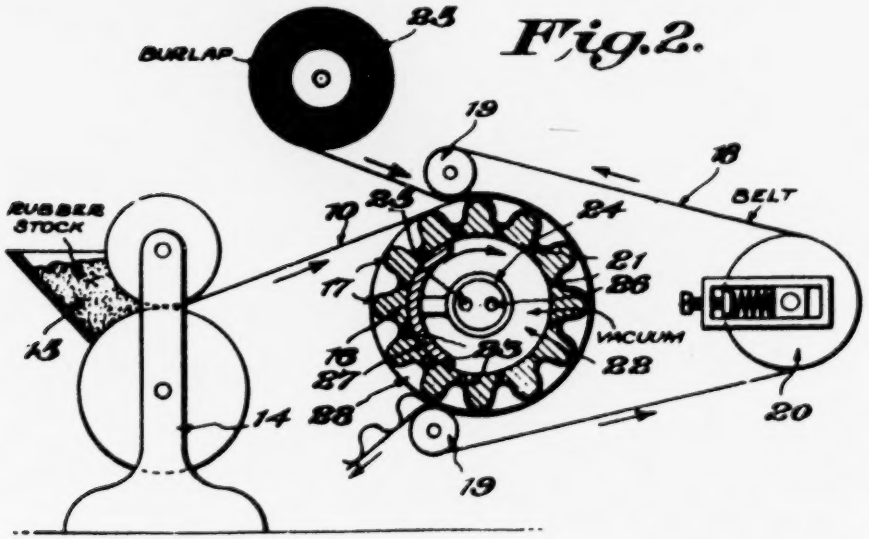
METHOD OF MAKING LAMINATED CUSHION MATERIAL

Original Filed Jan. 2, 1942

Fig. 1.

Fig. 3.

Fig. 2.



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Attorneys

Patented Aug. 30, 1949

2,480,316

UNITED STATES PATENT OFFICE

2,480,316

METHOD OF MAKING LAMINATED CUSHION MATERIAL

George W. Blair, Mishawaka, Ind., and Virgil H. Bodle, Los Angeles, Calif., assignors to Mishawaka Rubber and Woolen Manufacturing Company, Mishawaka, Ind., a corporation of Indiana

Continuation of application Serial No. 425,462, January 2, 1942. This application November 11, 1944, Serial No. 562,986

3 Claims. (Cl. 154—33.66)

1

This invention relates to elastically yieldable laminated flexible material, and an improved method of making such material, and this application is a continuation of our prior application, Serial No. 425,462, filed January 2, 1942, now abandoned.

While capable of many uses, the product of the present invention is particularly adapted as a carpet or rug underlay. In such adaptation, it provides a rug padding having desirable cushioning and anti-slip or non-skid properties.

It is an important object of the invention to produce a strong, durable and inexpensive material which will possess elastically yieldable characteristics in the direction of the depth or thickness of the material, thereby particularly adapting the material for use as a carpet or rug underlay.

The product of the present invention includes a thin sheet of rubber material shaped to provide hollow open sided embossments, and a backing sheet, such for instance as burlap, Osnaburg, or other inexpensive fabric, preferably of relatively open weave, applied and secured to one side of the rubber sheet and closing open sides of the embossments, thereby reinforcing the embossments and preventing collapse thereof under stress applied thereto and trapping atmospheric air in the embossments so as to provide the product with a plurality of air cells of material size such as will give cushioning or elastically yieldable characteristics to the product.

It is an important object of the invention to provide an improved method of and apparatus for producing the rubber lamination or sheet element and embossing the same in a continuous operation, and at the same time applying and securing the backing element thereto, whereby the complete material may be produced as a continuous operation and the composite material made in continuous sheets of any desired lengths in a simple and inexpensive manner.

The present invention permits of the use of inexpensive rubber stock such as may be calendered into thin rubber sheets of slight elastic characteristics, and it is an object of the present invention to provide for including such a sheet in a composite product which is elastically yieldable in the direction of its depth or thickness for the purpose of the present invention.

2

In the drawings:

Figure 1 is a sectional perspective view of the product of the present invention.

Figure 2 is a diagrammatic view in side elevation of an embodiment of an apparatus for carrying out the method of the present invention.

Figure 3 is an enlarged fragmentary detail of the embossment-forming drum.

The product of the present invention has been shown in Figure 1, wherein 10 designates a thin, more or less flimsy, sheet or lamination of rubber, bent, shaped or otherwise formed into convolutions, corrugations or hollow ribs 11, which in the present embodiment, are shown as extending transversely across the width of the sheet and constituting open sided embossments. Applied to one side of the rubber sheet is a backing sheet 12 of suitable material, such for instance as burlap, although other material may be employed as a backing to reinforce the more or less flimsy sheet of rubber material. The backing sheet 12 touches and is secured to the peaks or tops of the embossments or corrugations at one side of the rubber sheet as by a layer or coating 13 of cement, rubber or the like, or by being vulcanized directly thereto. This backing sheet bridges and closes the open sides of the embossments at one side of the rubber sheet and ties together the closed sides of successive embossments or corrugations on the same side of the sheet and thereby prevents collapse of the hollow embossments which have their open sides closed by the backing sheet 12. The backing sheet also reinforces the corrugated rubber sheet, and puts the composite sheet in proper condition for handling, as well as preventing collapse of the corrugated or embossed rubber sheet.

The present product is comparable to a sponge or cellular rubber sheet, and has the advantage that, while blowable cellular or sponge rubber may be used, nevertheless, inexpensive non-cellular rubber stock may be employed, for the reason that by corrugating or providing the rubber sheet with hollow open sided embossments and employing the backing sheet as shown, the composite sheet will have a plurality of air cells defined by the hollow corrugation. The corrugations are open to the atmosphere at opposite ends of the corrugations, and these small openings permit breathing so that the desired cushioning effect is obtained.

While in Figure 1, the composite product is shown with the backing sheet 12 on the underside of the rubber sheet 10, yet when employing the product as a rug or carpet underlay, the backing sheet 12 may be uppermost or on top whereby the backing sheet will present a rough coarse surface to the underside of a rug or carpet laid thereon and tend to prevent slipping of the rug or carpet edgewise, and thus the new product has advantageous non-slip characteristics.

An apparatus for producing the product of the invention has been shown diagrammatically in Figure 2, wherein 14 designates a suitable calender for continuously forming a batch of rubber stock 15 into the sheet 10 which is led from the calender around the periphery of a rotatable hollow drum 16 having spaced longitudinal ribs 17, by an endless belt 18 trained around suitable guide rolls 19 and 19' and also around a belt tensioning roll 20, the guide rolls 19 being positioned with respect to the drum 16 so as to cause a portion of the belt to partially embrace the periphery of the drum in close relation therewith to cause the rubber sheet 10 to hug a substantial extent of the periphery of the drum. The pressure of the belt 18 against the drum 16 may be regulated by adjustment of the tension roll 20. In the calendering operation the rubber is heated, and if supplied directly therefrom to the drum 16, as shown in the drawing, so that it is not appreciably cooled it is soft enough so that it will gravitate into the channels of the shaping drum 16. However, a suction pull may be added to that of gravity, as by the employment of radial openings 21 provided through the peripheral wall of the drum 16, preferably in the form of slots extending the length of the drum and preferably located between successive ribs 17 so as to constitute passages communicating between the interior chamber 22 of the hollow drum and the channels 23 between the ribs 17. The interior chamber 22 of the drum will be put in communication at one or both ends of the drum with an air exhaust or suction apparatus, not shown, so that the portion of the rubber strip which is partially embracing the drum in contact with the outer edges of the ribs 17 will be subjected to the pull of the exhaust or suction drum and thereby sucked or drawn into the channels 23, whereby the rubber sheet will be caused to take on the corrugated shape of the periphery of the drum, thus providing the sheet with the hollow ribs 11 constituting hollow embossments which are open throughout their outer sides. Preferably the drum 16 is provided, at either end, with an annular flange 28, or other appropriate means for closing the ends of the drum channels 23 in order to insure the effectiveness of the suction upon the rubber material.

If desired, the hollow shaping drum may also be heated, in any suitable manner, not shown, but preferably by the injection of steam into the interior chamber 22 of the drum, so as to vulcanize the rubber sheet during the shaping thereof and while the backing sheet is being applied thereto.

While any suitable manner of exhausting air from the chamber 22, and also of heating the drum 16 may be employed, we contemplate rotatably supporting each closed end of the drum on a fixed stub shaft 24, which may be provided with passages 26 and 26, communicating with the chamber 22, one for connection with an air exhaust or suction device and the other for connection with a source of steam for heating the drum. Other ways of heating the drum may be employed for softening the rubber so that it may readily conform to the corrugated periphery of the drum, and for vulcanization purposes where vulcanization is desired when the rubber sheet is on the drum. Also other ways of exhausting air from or providing a suction in the chamber 22 may be employed.

Ordinarily the rubber sheet will, by reason of its softened condition, gravitate into the channels 23 and remain there until stripped or led away from the drum by the pull of a winding drum or roll, not shown, employed for storing the completed product. However, suction may be employed, if desired, to assist in conforming the rubber sheet to the corrugations.

Any suitable means may be employed for closing such openings 21 as may not be covered by the rubber strip, as for instance a fixed closure member 27 supported from the fixed stub shafts on which the drum 16 rotates. However, it is not absolutely necessary to provide for closing such openings as only a slight pull on the rubber sheet in addition to that of gravity will suffice if gravitation in some instances is not altogether satisfactory. Also, we contemplate closing the opposite ends of the channels 23, as by means of an annular flange 29 at each end of the drum, if under some conditions it should become necessary or desirable in order to obtain the desired pull or suction on the rubber sheet passing around the drum.

The flexible backing sheet 12 of suitable textile or other strong and durable preferably open material, such as burlap, Osnaburg, or the like, is led, from a source of supply 29, between the portions of the rubber sheet 10 and the belt 18, which partially embrace the drum 16, so that the burlap will be carried along with the rubber sheet or strip in contact with the outer closed sides of the ribs 11 of the rubber sheet until the corrugated rubber sheet and the backing sheet thereon are discharged from the apparatus at the point where the guide roll 19' leads the endless belt 18 away from the drum. It will here be explained that the rubber sheet portion which is being led around the embossment-forming or shaping drum is sufficiently soft to conform to the shape of the periphery of the drum under the suction action.

The backing sheet being relatively porous and inelastic, will not be sucked into the corrugations of the drum but will remain in its original condition and will lie against the outer closed sides of the corrugations or embossments of the rubber sheet to which the backing sheet will be connected, as by the employment of a suitable cement or rubber coating 13 applied to either or both of the sheets preparatory to being passed around the forming or shaping drum.

Each or any selected rotating or moving element of the apparatus may be driven according to the character and condition of materials employed and the conditions under which the apparatus may be operating.

Vulcanization need not necessarily be accomplished during the laminating and forming operations on the drum 16, as the important consideration is the embossing of the rubber sheet and the assembly therewith of the backing sheet. If vulcanization does not occur, or is only partially attained, by the heat of the drum, then the laminated sheet leaving the same may be subjected to further heat treatment in a suitable apparatus, such as a belt conveyor or festoon vul-

canizer, for the purpose of producing or completing vulcanization. However, the employment of a heated hollow shaping drum lends itself admirably to the heating step of vulcanization simultaneously with the shaping of the rubber sheet.

While the calendering of a batch of rubber stock followed immediately by the embossing step and the assembly of the embossed sheet and the backing sheet is desirable and important, it will of course be understood that a preformed rubber sheet may be fed to the shaping drum from a suitable source of supply, such as a roll of a continuous strip of rubber, and heated by the heating drum sufficiently to soften the rubber sheet or strip so that it will conform to the configuration of the periphery of the drum.

Wherever in the specification and claims the term "rubber" or "rubber-like material" is used the same is intended to include natural rubber compounds and any similar natural or synthetic thermoplastic vulcanizable substances.

It is an important feature of the present invention that in the shaping of the rubber sheet in the corrugated form no companion corrugating roll or drum is employed, this being important as the soft, heated unvulcanized rubber is likely to stick thereto and interfere with the proper retention of the rubber sheet in the corrugations of the drum 16.

Thus as the heated soft sheet rubber is laid on the drum 16 it straddles the valleys between the adjoining corrugations thereof and solely by gravity, assisted by suction if necessary, the straddling rubber is distended and sinks into the valley and thereby conforms to the corrugated form of the surface of the drum 16, in which position it is maintained until vulcanized and removed from the drum. By this method no companion corrugation roll is required, the rubber being given the corrugated shape by application of shape defining means to only one side of the rubber sheet and any disturbance or displacement of the rubber after it is shaped to the corrugated form of the drum surface is thereby avoided. Accordingly the valley straddling portions of the rubber sheet are pulled down into the valleys as distinguished from pushing thereof into the valleys by a mating corrugated roll.

The hollow ribs or corrugations 11 of this composite sheet may if desired contain a filler which is held therein by the backing sheet 12. Such filler may be of ground sponge rubber, sawdust or the like.

While we have described our invention in a preferred form, we are aware that various changes and modifications may be made without departing from the principles of our invention, the scope of which is to be determined by the appended claims.

What we claim is:

1. The method of making laminated cushion material of the class described, which said method comprises calendering a sheet of vulcanizable plastic material, then heat softening the sheet progressively lengthwise and pulling successive heat softened portions thereof consecutively sidewise and thereby forming successive corrugations, then continuously advancing a backing sheet conjointly with the corrugated vulcanizable plastic sheet along a predetermined path in contacting side by side relation and, throughout a substantial length of said path, constantly compressing said backing sheet against crown portions of a series of the corrugations and simultaneously subjecting said crown portions to vulcanizing temperature and thereby vulcanizing said crown portions to the backing sheet.

2. The method of making laminated cushion material of the class described, which said method comprises calendering a sheet of vulcanizable plastic material, then heat softening the sheet progressively lengthwise and pulling successive heat softened portions thereof consecutively sidewise and thereby forming successive corrugations, then continuously advancing a backing sheet conjointly with the corrugated vulcanizable plastic sheet along a semi-circular path in contacting side by side relation and, throughout said path, constantly compressing said backing sheet against crown portions of a series of the corrugations and simultaneously subjecting said crown portions to vulcanizing temperature and thereby vulcanizing said crown portions to the backing sheet.

3. The method of making laminated cushion material of the class described, which said method comprises calendering and thereby heating a sheet of vulcanizable plastic material, then, before dissipation of any appreciable heat of calendering, further heating and softening the sheet progressively lengthwise and pulling successive heat softened portions thereof consecutively sidewise and thereby forming successive corrugations, then continuously advancing a backing sheet conjointly with the corrugated vulcanizable plastic sheet along a predetermined path in contacting side by side relation and, throughout a substantial length of said path, constantly compressing said backing sheet against crown portions of a series of the corrugations and simultaneously subjecting said crown portions to vulcanizing temperature and thereby vulcanizing said crown portions to the backing sheet.

GEORGE W. BLAIR.
VIRGIL H. BODLE.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1961.
No. .....

RUBBER CORPORATION OF CALIFORNIA,
Petitioner,

vs.

NATIONAL SPONGE CUSHION CO., INC.,
Respondent.

Respondent's Opposition to Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

I.
Background.

The Motion for a New Trial, upon which the present Petition for a Writ of Certiorari is based, was denied by the District Court, denied by the Court of Appeals for the Ninth Circuit, and now the petitioner is endeavoring to reverse the concurring decisions of the District and Circuit Courts.

II.
Filed Too Late?

The petitioner here prays that a writ of certiorari may issue to review the judgment of the Court of Appeals for the Ninth Circuit entered on February 8, 1961 [Tr. pp. 142-150]. A Petition for Rehearing of

that judgment was denied on March 21, 1961 [Tr. p. 152]. The present Petition for a Writ of Certiorari was filed in this Honorable Court in November, 1961, or approximately eight months after the final decision of the Court of Appeals which petitioner now wishes to have reviewed. It is believed that this Petition comes approximately five months too late in order for this Honorable Court to review the judgment of the Ninth Circuit. The time within which petitioner should have filed a Petition for a Writ of Certiorari expired ninety (90) days after the Petition for Rehearing was denied, to wit, in June, 1961, ... U. S. C. §2101(c)*

The authorities appear clearly to hold that the present Petition should have been filed within ninety (90) days of the denial of the rehearing on March 21, 1961.

> "It is insisted by counsel for the petitioner that it is within our power and it is our duty on this writ to go into the merits of the issue of the validity of the Smith patent. . . . The application for this second writ of certiorari which we are now considering was not made until May 22, 1922, more than three months after the final decree in the circuit court of appeals for the payment of profits. Section 6 of Act of September 6, 1916 (Chap. 448, 39 Stat. at L. 726, 727, Comp. Stat. § 1228a, Fed. Stat. Anno. Supp. 1918, p. 422), directs:

*"Any other appeal or any writ of certiorari intended to bring any judgment or decree in a civil action, suit or proceeding before the Supreme Court for review shall be taken or applied for within ninety days after the entry of such judgment or decree. A justice of the Supreme Court, for good cause shown, may extend the time for applying for a writ of certiorari for a period not exceeding sixty days."

"'That no writ of error, appeal, or writ of certiorari intended to bring up any cause for review by the Supreme Court shall be allowed or entertained unless duly applied for within three months after entry of the judgment or decree complained of.'

"This deprives us of jurisdiction to consider the merits of the decree of October, 1921.

"In the case before us, the decree of October, 1921, which we declined to review in January, 1922, was a final decree, and we are expressly denied power to review it after three months."

Toledo Scale Co. v. Computing Scale Co., 1922, 261 U. S. 399, 417, 67 L. Ed. 719.

"Where a petition for rehearing is entertained, the judgment does not become final for purposes of our review until such petition has been denied or otherwise disposed of, and the three months' limitation begins to run from date of such denial or other disposition."

Citizens' Bank of Michigan City v. Opperman, 1919, 39 S. Ct. 330, 249 U. S. 448, 63 L. Ed. 701.

"The running of the time within which proceedings may be initiated here to bring up judgment or decree for review is suspended by the seasonable filing of a petition for rehearing. But it begins to run from the date of denial of such petition and further suspension cannot be obtained by the mere presentation of a motion for leave to file a second request for rehearing."

Gypsy Oil Company, Petitioner v. Lee Bennett Escoe, a Minor, by O. W. Stephens, Guardian, etc., 275 U. S. 498, 72 L. Ed. 393.

It would appear, therefore, that the present Motion for a New Trial did not extend the time within which the petitioner should have filed its present Petition for a Writ of Certiorari, inasmuch as the present Petition is at best only "a second request for rehearing" of the Ninth Circuit's judgment, and at worst it is a brand new motion for new trial that is based upon an alleged new set of facts. In either event, it is believed the present Petition was filed five months too late as far as the final judgment of the Ninth Circuit on March 21, 1961, is concerned.

III.
Later Motion.

The petitioner has joined two petitions in its present Petition for a Writ of Certiorari, viz., (1) a petition to review the above judgment of the Ninth Circuit, of February 8, 1961; and (2) a Motion for Permission for the District Court to Decide On Its Merits defendant's Motion for a New Trial, under Rules 59 and 60 F. R. C. P. The latter Motion for a New Trial is a separate and distinct proceeding from the said first Motion, and is based upon alleged newly-discovered evidence. This Motion for a New Trial does not ask for reconsideration of the Ninth Circuit's judgment of February 8, 1961, because it only asks for a new trial in which to present some purportedly new evidence. Thus, we have two entirely different Motions in the present single Petition.

The filing of said Motion for a New Trial in April, 1961, did not toll the running of the ninety (90) days within which petitioner was required to file its Petition for a Writ of Certiorari, from the denial of a re-

hearing on March 21, 1961. The petitioner did not extend this ninety-day period, by filing a separate Motion for a New Trial based upon alleged newly discovered facts, as explained above.

Therefore, only the petitioner's Motion for a New Trial is before this Honorable Court.

IV.
Question for Review.

The petitioner has presented two rather vague and difficult-to-understand questions for review in this case. During the hearing before the Court of Appeals on the petitioner's present Motion for a New Trial, Judge Pope of the Ninth Circuit, who presided at the hearing, asked the present petitioner's counsel a rather embarrassing question which is believed to state more accurately the question involved in this petition for certiorari than the rather involved, ambiguous questions presented by petitioner. Of course, no record was made of the oral hearing before the Court of Appeals on said Motion but to the best recollection of the undersigned, Judge Pope's question to opposing counsel was substantially as follows:

> "If you had some evidence available at the time of trial, which you chose not to use until after an appeal had been heard and decided against you, could you then come in and ask for a new trial to prove the evidence which you chose not to use at the trial?"

It is sincerely believed that the above is an accurate report of Judge Pope's question. If counsel for the petitioner here disputes this, then the undersigned will adopt it as his own suggestion of a clearer word-

ing of the only question involved in the present Petition, although the authorship thereof is not claimed because the idea was prompted by Judge Pope's question which the above is believed to accurately reproduce as to substance.

V.
Too Late for a Motion for New Trial?

If petitioner's Motion for Permission for the District Court to Decide On Its Merits Defendant's Motion for a New Trial is the same as, or governed by the same rules as, a Motion for a New Trial (which it is believed to be), then even that part of the present Petition appears to have been tardily filed.

It would appear from Rule 59(b)* that a Motion for a New Trial should have been served not later than ten days after the entry of the judgment on the Petition for Rehearing, to wit, March 21, 1961. The date of petitioner's Motion for Permission *re* its Motion for New Trial is April 13, 1961. Obviously, the petitioner here has not complied with Rule 59(b) as to the time within which a motion for new trial should have been served after the entry of the judgment.

VI.
What Are Petitioner's Grounds?

The second half of the second part of the Motion here is for relief under Rule 60(b), from the judgment of the Ninth Circuit refusing a new trial. It will, however, be noted that petitioner is very careful not to choose which of the grounds in Rule 60(b) it

*"(b) Time for Motion. A motion for a new trial shall be served not later than 10 days after the entry of the judgment. As amended Dec. 27, 1946, eff. March 19, 1948."

claims to come under. The petitioner made it clear before the lower court, whose decision was appealed from, and which is now before this Honorable Court, that it urged that the present facts constituted "newly discovered evidence . . . which could not have been discovered before trial by the exercise of reasonable diligence." [See Harrington Affidavit, Appendix B, annexed to this brief].

Nowhere in its present Petition does the petitioner state whether it contends that the alleged laboratory model, which they recently built, was not produced at the original trial hereof because of "mistake," "inadvertence," "excusable neglect," "newly discovered evidence," "fraud" or "any other reason," all being grounds under Rule 60(b). It is believed that none of these grounds exists in the present case, as explained hereinafter.

VII.

What Are Facts in This Case?

At the trial of this case the petitioner (the infringer) relied heavily upon prior Blair-Bodle patent No. 2,480,316, which will hereinafter be referred to as '316. A copy of this patent '316 was introduced by the petitioner at the trial and it was emphasized to the jury at the time the case was submitted for their verdict. The peitioner admitted that it relied heavily upon this patent at the trial of this case. [Tr. Vol. IV, p. 3, lines 18-20 of Proceedings on May 1, 1961 before Lower Court].

The trial in the district court in this case was conducted from May 27, 1958 to June 11, 1958. It was not until April, 1961, or almost three years later, that the petitioner-defendant got around to building a purported

laboratory model of the machine shown in patent No. '316, which it now claims disproves the statements made by the Court of Appeals as to this patent. The main question, then, in this case, is whether a litigant can obtain a new trial after an appeal has become final, on the ground that it did not make the model of a patent at the time of the trial, which patent it knew all about because it heavily relied upon same at the trial. The petitioner could just as easily have built three years before what it built three years later.

It appears that the petitioner is lacking in diligence since no valid reason is given why it could not have made the model previously. That due diligence in obtaining the evidence must positively be shown, see *Raske v. Raske*, 92 Fed. Supp. 348, as follows:

> "Due diligence to obtain the evidence must be shown to justify a new trial upon the basis of newly discovered evidence."

The error of the petitioner in not making the purported model at the time of the trial was not a mistake, inadvertence, excusable neglect, newly discovered evidence, fraud, or any other reason which would appear to warrant a new trial. The only thing newly discovered is that the petitioner now thinks that such a model might have been of value.

The respondent here believes that it has a complete answer to the petitioner's claim that the product of the laboratory model lately made by the petitioner anticipates the patent in suit. However, that relates to the merits. As stated by the petitioner on page 16 of its Petition, the said petitioner is not requesting this Honorable Court to decide the merits of petitioner's Motion (after spending ten pages on the merits thereof).

VIII.

Petitioner Asks More Delay.

It has taken over five years (almost one-third of the life of the patent in suit), to get to this point in the litigation and if a new trial be granted on this matter (which the petitioner could just as easily have produced at the time of trial), then petitioner would undoubtedly appeal from such a second trial, again ask for a rehearing in the Court of Appeals, and again petition this Honorable Court in connection with such subsequent trial. This further delay would appear especially burdensome because it is based upon the false premise that the petitioner has the option of deciding not to use certain evidence available to it at the trial, and later on be granted a new trial when it decides that it should have presented such evidence in the first place.

At the time of the trial and during the first appeal in this case, the petitioner advanced the same theory that it presents now. It should be borne in mind that the patent in suit is not on the machine but is on sponge rubber carpet-underlay material that provides a cushioning effect under a carpet. The petitioner's theory is that the machine shown in patent '316 can be made to produce the present patented product, and they claim to have made "tests" three years too late to prove this.

It did not take petitioner very long to build whatever it has now built (which has never been shown to respondent), since the machine was built between March 21, 1961 and April 13, 1961 (respectively, the date of the Court of Appeals denial of rehearing and the date of petitioner's Motion for a New Trial based on the

"machine"). Thus, the alleged machine was built and purported products thereof were produced in not more than 23 days. No doubt the petitioner could just as quickly have built this experimental, laboratory "machine" three years before for the trial of this case, if it had so desired. Obviously, whatever the petitioner has done lately it could have done, by the exercise of reasonable diligence, at the time of the trial of this case.

At the trial, the petitioner offered in evidence both drawings and specification of this "machine," since they are contained in patent '310. Now, petitioner asks for a new trial merely to offer in evidence the physical counterpart of the same thing that it offered in documentary form at the trial. This physical evidence would be merely cumulative as far as that patent is concerned. The same amount of activity three years before would have produced this same model. This evidence was not "newly discovered." The petitioner's only subsequent discovery is the alleged *importance* of the evidence.

IX.
"New" Evidence Already Considered.

The petitioner argues here that it has the right to be heard "on the merits" of this patent '310. What is believed to be a complete answer to this contention is that the Court of Appeals for the Ninth Circuit has already considered the subject matter of this patent "on the merits." The petitioner has already had its "day in court" as to this patent.

It is believed that the Court of Appeals without question decided this same argument on its merits, during petitioner's first appeal. This precise contention clearly

was given in petitioner's "Answering Brief" and in its "Petition for Rehearing [annexed hereto as Appendix A]. It will be noted at the bottom of page 8 of the present Petition that the petitioner argues that if patent '310 is practiced as taught it "will inherently result" in the production of the product of the patent in suit. Then on page 9 of the present Petition, the petitioner argues that the key-lock of the patent in suit is "an inherent and inescapable result" of the teaching of this prior art patent.

In its original "Answering Brief," the petitioner made these same arguments to the Court of Appeals for the Ninth Circuit. As shown by said "Appendix A," the petitioner at that time quite exhaustively argued that patent '310 "must of necessity" key-lock and that "the only conceivable result" of patent '310 is the present product. Moreover, that the product of patent '310 "would of inescapable necessity" comprise sponge rubber having a key-locking engagement with the fabric.

As evidence that the Court of Appeals fully considered this argument, so that the petitioner had its day in court "on the merits" of this argument, it should be noted that the Court of Appeals in the footnote on page 145 of the record here states as follows:

> "Appellee suggests that since this patent contemplated the use of blowable cellular or sponge rubber, that the blowable sponge rubber would project into and through the open mesh fabric thereafter widening and forming the key-lock referred to in plaintiff's claims. There is no evidence to support such a contention, and nothing in the Blair-Bodle patent to suggest that any such thing was con-

templated. On the contrary, the patent suggests quite the opposite. It states that the heated rubber 'is soft enough so that it will gravitate into the channels of the shaping drum.' It suggests that a suction pull may be added to that of gravity. The quoted description refers to a pull by gravity or suction precisely opposite to that which is described in plaintiff's patent. This gravitating into the channels of the shaping drum is a process to form the waffle-like ridges or projections, the push or pull being away from and not toward the fabric."—286 F. 2d 731, 733 (1961).

It should be noted that this is the decision of the Court of Appeals for the Ninth Circuit which has become final, since no Petition for a Writ of Certiorari was filed in this Honorable Court within three months after the final decision when the Petition for Rehearing was denied on March 21, 1961. Thus, the Court of Appeals has already finally determined on its merits that the product of patent '316 will not inherently result and that a key-lock is not an inherent and inescapable result of that patent.

The petitioner argues that it has had no "opportunity to be heard on the merits of its motion." This is not correct. They have already passed by two opportunities, to wit, the trial three years before, and the Petition for Reconsideration, supported by the Bodle affidavits, two years before. Now, petitioner wants a *third* opportunity. There should be an end sometime.

In summary of this part of this brief, it is believed that the purported laboratory model, which petitioner now wishes to offer, is not "newly discovered evidence,"

and that petitioner's extreme tardiness in not bringing it forward three years before at the time of the trial constitutes inexcusable neglect. This is not the case of some records that were lost at the time of trial and later discovered, nor is there any new "discovery" in connection with this purported machine, because it is both shown and described in patent '316 that was offered in evidence at the trial. The petitioner has at all times relied heavily upon this patent, and has made this same argument, based on this patent, both at the time of the trial and on the two appeals to the Court of Appeals in this case. What the petitioner alleges is that now it has made a "machine." It could of course have made or "discovered" this same machine before the trial of this case by the exercise of reasonable diligence, because the information concerning it was available to petitioner throughout the trial in this case. The same activity at the time of the trial would have produced whatever model it has now made. This is not subsequently discovered evidence; the petitioner only subsequently discovered that they thought the evidence was important. Its arguments of what it now claims this machine proves have already been repeatedly and vigorously voiced. Their contentions have been made over and over again, at the trial, on the first appeal, and on the second appeal. The Ninth Circuit has ruled twice against petitioner. Petitioner has had more than its day in court on this oft repeated argument.

X.

Circuit Court Decision Not Based on Affidavits.

The petitioner here has set up a straw man and then endeavored to knock him down. It is the contention of the petitioner that the Court of Appeals had a "parallel theory" to certain affidavits filed herein. It is not clear what a "parallel theory" is. If petitioner means that the Court of Appeals arrived at the same conclusion as the affidavits, then to that extent they are similar, not parallel. If the petitioner means that the evidence upon which the Court's decision and the affidavits were based is the same, then it is believed that the petitioner is in error.

One very important point in this connection is that the Court of Appeals did not base its decision upon the Bodle affidavits which petitioner attacks so strenuously in its present Petition. The petitioner's "Argument" in its second appeal in this case, admitted that the Court of Appeals "makes no mention of the affidavits of Bodle" [Tr., Vol. V, p. 2 of "Argument" —third p. "2" of this Vol.]. As noted in the quotation *supra* from the Ninth Circuit case, quoted from page 145 of the Transcript, the Circuit Court based its conclusions entirely upon the patent itself. For instance, the said portion of the Circuit Court's decision states, "On the contrary, the patent suggests quite the opposite. It states. . . . It suggests. . . . The quoted description [of patent '316]. . . ." Also see the statement that there is "nothing in the Blair-Bodle patent to suggest that any such thing was contemplated." In other words, the patent itself was the entire basis of the Ninth Circuit's decision that what the petitioner is now urging was not contemplated by

those patentees. It is believed that the careful analysis of this patent '316 by the Court of Appeals is extremely accurate and carefully considered after strenuous arguments by the petitioner to the contrary [see Appendix A hereto].

Thus, it is believed that the several pages of the present Petition which attack the affidavits of Bodle are of little consequence since the Court of Appeals based its decision, not upon said affidavits, but upon the Blair-Bodle patent '316 itself. However, it is believed that the Court of Appeals would have been correct in basing its decision upon said Bodle affidavits, if it had done so.

Even if said affidavits had been the basis of the Court of Appeals' decision, it should be noted that the petitioner here failed and neglected to make any answer whatsoever to the Bodle affidavits which were filed in April and May, 1959, until after the Petition for Rehearing on the appeal had been denied in March, 1961, or almost two years later. Thus, there was inexcusable neglect on the part of the petitioner to come forward with any such purported laboratory model for some two years after the date of the affidavits which it belatedly wishes to dispute. In other words, the Bodle affidavits were entirely undisputed by petitioner for almost two years, as far as building a machine was concerned, which is the only basis for the present Petition. In fact, the only claim that the petitioner is now making is that it has now built some sort of a laboratory model which it never built before, although it could have.

XI.

District Court Decided "on Its Merits."

It is believed that the District Court decided the present subject matter upon its merits in the proceeding on May 1, 1961 (Vol. IV), since that Court held that petitioner had come into the District Court with the same thing that it had presented at the trial. The District Court stated as follows:

> "When you came in with it before, you came in with the documentary evidence. Now you propose to come in with the machine. I don't think you have got a prayer on this motion, but go ahead and make it." [Tr., Vol. IV, p. 3, lines 13-16].

That is to say, exactly the same subject matter was before the lower court at the time of the trial in 1958, and the petitioner in 1961 was merely offering a small, experimental model which it claims to be a "counterpart" of what is in patent '310 [Tr., Vol. IV, p. 6, lines 10-12]. Thus it appears that the District Court decided on its merits that the petitioner was merely trying to bring in the same thing in physical form which it had in documentary form at the time of the trial three years before. This, the District Court said, on its merits, cou'd not be done. The District Judge implied that this counterpart of what was offered at the trial was not "newly discovered evidence" or "any other reason" for relief from the judgment.

While the District Court felt that said patent did anticipate the patent in suit, nevertheless, in view of the Court of Appeals' final judgment that it did not, District Judge Tolin felt that the petitioner could not now come in with a model in alleged physical form, when

the same subject matter was considered carefully by the Court of Appeals in documentary form.

The petitioner is fond of saying that the District Judge agreed with petitioner's contention that the patent in suit was invalid. However, the Lower Court was *reversed* by the Court of Appeals on this point, in a decision that is now final. The District Judge did, however, decide on its merits that the petitioner could not at this late date come in with an alleged physical embodiment of the same thing that it presented in documentary form at the trial, and that the petitioner did not have "a prayer" to do that. The District Court was *affirmed* on this point, and that is the only question involved in the present motion (not whether the patent in suit is valid or invalid).

The petitioner has tried to discredit the Bodle affidavits by saying that they were "unsubstantiated, self-serving, *ex parte* affidavits." The fact that they were under oath and undisputed by the petitioner for almost two years would appear to indicate that they were substantiated. It would appear that all affidavits are self-serving in the meaning of assisting the party who submits them. If they did not help to serve the party's cause, they would not be filed. Moreover, it is not a valid objection that an affidavit is "*ex parte*." It is very seldom that an affidavit is joined in by both sides so that practically all affidavits are *ex parte*. Thus, none of these epithets used by petitioner seems to disparage the affidavits in question.

The petitioner also labels these affidavits as "late." It should be noted in answer to this that the affidavits were in support of the respondent's Petition for Reconsideration of the judgment by the District Court.

They were filed seasonably for that purpose and no contention has been or can be made that they were not filed in due time in support of that Petition. Obviously a party could not file affidavits in support of a petition for reconsideration of a judgment, prior to the entry of such judgment. Thus the position of the petitioner seems untenable since said affidavits were believed clearly filed at the proper time in support of said Petition for Reconsideration.

XII.

Petitioner Gambled on District Court Decision.

The petitioner endeavors to excuse its long delay in building the small laboratory model, which they have now purportedly constructed, by stating that there was "no earlier need for it." However, petitioner gambled that there would be no need for it at the trial, and gambled that the District Judge would rule for them on the respondent's Petition for Reconsideration. It was a gamble because the petitioner undoubtedly did not know *in advance* that the District Judge was going to rule in petitioner's favor on said Petition.

The petitioner won its gamble before the District Court because the District Court denied the Petition for Reconsideration, but it later developed in this case that there was a "need" for it before the Court of Appeals two years later. Even then, despite the "need" for it, the petitioner did not build whatever it has now built until after final judgment by the Court of Appeals and after denial of the Petition for Rehearing. Then, and only then, in order to be able to file a Motion for a New Trial and for Relief from the Judgment, did the petitioner finally decide to build an experimental, lab-

oratory model, to try to substantiate its oft repeated theories of patent '316.

The petitioner has also complained that it did not have time enough in which to make this alleged machine between the filing of the Bodle affidavits and the denial by Judge Tolin of the respondent's Petition for Reconsideration. In the first place, the petitioner did not request any additional time (the respondent has stipulated to every extension requested by the petitioner in this case).

The respondent is willing to stipulate that the petitioner does not agree with the Bodle affidavits or with the Court of Appeals for the Ninth Circuit, but whether petitioner would like to dispute same now is not the question. The question now is whether this small laboratory model, which it could have built three years before, at the time of the trial, is "newly discovered evidence," or whether petitioner is guilty of inexcusable neglect in failing to do then what it very quickly did last spring. The petitioner admitted at the hearing before the Court of Appeals in this matter that they did not know whether this was "newly discovered evidence," but that Rule 60(b)(6) includes the catch-all phrase "any other reason." However, it is submitted that "any other reason" does not apply to a party who delays three years in bringing forward what it could have produced at the time of the trial.

By logic, if the Court of Appeals carefully considered the subject matter of the documentary proof of patent '316 (which the record shows it did and which is undisputed by petitioner), and if the model which petitioner has purported to have built is the "counterpart" of said patent '316 (as it claims), then the in-

escapable conclusion is that the Court of Appeals did consider the subject matter of the "machine" on its merits, since things equal to the same thing are equal to each other.

XIII.

Does Petitioner Admit Evidence Not "Newly Discovered"?

Ever since the present petitioner argued in its first brief that the present evidence, which it now wishes to present, was "newly discovered evidence," and that it could not have been produced at the time of the trial by the exercise of reasonable diligence, it has been soft pedalling the argument that this evidence is newly discovered. However, the very basis of its petition here is that it is trying to convince this Honorable Court that said evidence is newly discovered, and that they should now be permitted to come forward with it.

The petitioner faces a dilemma in this connection, since obviously the evidence is not "newly discovered," and petitioner is impliedly admitting that it is not since it has not lately made this argument. Of course, evidence that was available to it at the time of the trial can scarcely at this late date be called "newly discovered." On the other hand, the petitioner is compelled not to admit that it is not newly discovered because that would be admitting their laches in bringing forward this evidence.

XIV.

Post-Trial Experiments Are Not "Newly Discovered" Evidence.

The only thing that petitioner even claims to have at this late date are post-trial experiments which it contends prove its theory of the evidence that it offered at the trial. The conducting of post-trial experiments by a party in an effort to prove its theory of a case, which it presented at the trial, has been held not to be a proper basis for granting a new trial. See the following case, in which the Court of Appeals for the Tenth Circuit held that it should first be shown by the moving party that this evidence was not obtainable when it was the proper time for it to be brought forward:

> "The appellants contend that the verdict of the jury was contrary to the overwhelming weight of evidence in the case, and that the trial court abused its discretion in refusing to grant a new trial. They contend that in any event, *the court should have granted a new trial upon newly discovered evidence, disclosed by post-trial experiments conducted by appellants' expert, which is claimed to completely disprove the defendant's theory of the case as advanced by its expert.* But we think the court was well within its wide latitude of discretion in refusing to grant a new trial for either reason. . . . In any event, the evidence presented a jury question *and the newly discovered evidence developed by further experimentation related to the appellee's theory of the cause of the fire And, there is nothing to indicate that it was not*

obtainable during the trial of this case." (Emphasis added.)

Taylor v. Reo Motors, Inc. (10 Cir., 1960), 275 F. 2d 699, reversed on other grounds.

In a recent (November 16, 1961) decision of the Ninth Circuit, in *Locklin et al. dba Radiant Color Co. v. Switzer Bros., Inc.*, ... F. 2d ....., 131 U. S. P. Q. 294, post-decision tests were held properly rejected for failure to show justification of failure to present these matters at the time of trial:

> "It offered testimony relating to post-decision tests run by it. . . .
>
> "All of this evidence was rejected by the district court for failure of Radiant to show diligence or justification for its failure to discover and present these matters at the time of trial. . . . The time for testing of proof is the time of trial. Our judicial system does not contemplate that the rights of litigants shall be held in abeyance for months or years in order that hindsight may provide a more accurate appraisal of evidence."

The Court of Appeals for the Ninth Circuit has also held that when the same degree of activity would have produced the purported evidence at the time when it should have been raised, an untimely offer of the evidence in a Motion for a New Trial should be denied:

> "The application for a new trial will be denied where it appears that the degree of activity or diligence which led to the discovery of the evidence after the trial would have produced it had it been

exercised prior thereto. 39 Am. Jur. § 161, p. 168."

United States v. Branson (9 Cir., 1944), 142 F. 2d 232, 235.

"The application for a new trial will be denied where the degree of activity which led to the discovery of the evidence post-trial would have produced it had it been exercised prior to trial."

Eastern Air Lines, Inc. v. United States, 110 Fed. Supp. 409.

"After-investigation cannot supply, as newly discovered evidence, something that the defendant might have gone into before the trial, if it had been considered material."

Skerman v. Philadelphia & R. Ry. Co., 255 Fed. 85.

Failure of a party properly to evaluate evidence earlier is not ground for a new trial. See the following from *Aerated Products Co. v. Aeration Processes*, 95 Fed. Supp. 23 (S. D. Cal. 1950, Yankwich, J.):

"But liberal though the courts are in interpreting these new rules, they do not permit a litigant to seek a new trial upon the ground that there existed evidence which the counsel who tried the case failed to present to the court because of his *failure to evaluate it properly*. The principle was summed up by the late Judge Garrecht in one brief sentence: 'Subsequent discovery of the importance of evidence which was in the possession of applicant for new trial, at the time of the trial, does not entitle him to a new trial upon the ground

> of newly discovered evidence.' United States v. Bransen, 9 Cir., 1944, 142 F. 2d 232, 235." (Emphasis in original.)

Also from the same case:

> "Judge Garrecht used the language just quoted in which the court gave approval to the principle that the newly-discovered evidence rule does not include failure to evaluate properly evidence available at the time of trial. Or, as it has been otherwise put, it must be made to appear that the evidence proffered is 'in fact newly discovered and not merely the importance of it.' 66 C. J. S., New Trial, § 101, p. 293, and see Bradbury Estate Co. v. Carroll, 1929, 98 Cal. App. 145, 153-155, 276 P. 394."

The authorities cited by petitioner do not seem to be in point, since it does not appear in any of them that any court has ever allowed a party to re-try an issue on the ground that a party made a post-trial experiment some three years after the trial, where the same activity would have produced such experiment at the time of the trial. Nor has any court, cited by the petitioner, granted a new trial where only the importance of the alleged evidence was discovered after the time of the trial. Nor has the petitioner cited any authority in which a belated "physical embodiment" of a patent has been accepted years later as basis for a new trial when that very patent was heavily relied upon at the trial of the case.

XV.

(1) Late. (2) Late. (3) Late.

The petitioner here seems consistently to follow a pattern of being too late. It has been too late in at least three phases of this case. Strictly speaking, the Affidavit of Robert Cummings and the Supplemental Affidavit of Harry Schrage of April 19, 1961 were filed too late. These Affidavits were not served with the present Motion for a New Trial dated April 13, 1961, as definitely required by Rule 59(c).*

It is believed that these Affidavits should not be considered for this reason alone, although of course respondent believes that the subject matter of all of the affidavits submitted with the present Petition are objectionable for the reasons given hereinbefore.

The second late offering by petitioner is its lateness in offering its post-trial experimental model, which was delayed three years after the trial and two years after the Bodle affidavits which the petitioner is allegedly now trying to rebut.

The third lateness of the petitioner is that it did not within ninety (90) days petition for a writ of certiorari in connection with the now final judgment for the Court of Appeals for the Ninth Circuit dated February 8, 1961 and in which the rehearing was denied on March 21, 1961.

---

*"59(c) Time for Serving Affidavits. When a motion for new trial is based upon affidavits they shall be served with the motion . . ."

XVI.

Public Not Interested.

The petitioner waited until the very end of its Petition to fire a Parthian shot, to wit, that the question involved in this case if "of importance . . . to the public." Presumably the petitioner means by this statement that if the question they have raised is not decided in the present proceeding, and if it might have been decided in their favor, then the public will be the loser. The premises of the petitioner are believed to be false. This identically same question will be tried in another case, filed in the Southern District of California, in June, 1961, to wit, the case of *National Sponge Cushion Co., Inc. v. The Mansfield Tire & Rubber Co.*, No. 711-61-TC. The Complaint and Answer in the latter case are enclosed herewith as "Appendix C." It will be noted in paragraph 11A of the defendant's Answer in the latter case that this selfsame defense will be litigated:

> "The product or article of manufacture forming the subject matter of the claims of said patent is identical with or not patentably distinct from the product or article of manufacture naturally and inherently produced by practicing the method and using the materials and apparatus described in United States Letters Patent No. 2,480,316, in the name of G. W. Blair and V. H. Bodle entitled, 'Method of Making Laminated Cushion Material' and issued August 30, 1949, a date more than one year prior to the filing date of the application which resulted in the issuance of said patent No. 2,740,739."

William E. Faulk, General Manager of the Mechanical Rubber Goods Division of the defendant The Mansfield Tire & Rubber Company in said latter case, was a witness for the petitioner at the trial of the present case, after his deposition had been taken twice. Because of the working arrangement between the defendant here and the said Mansfield Tire & Rubber Company, as shown by the above-quoted part of latter's Answer, the present petitioner has obviously passed on to The Mansfield Tire & Rubber Company its theory of patent '316, which it is trying to assert in the present case. It seems obvious that one company knows what the other one knows about patent '316 and about said experimental "machine." Thus, there will be a full and complete adjudication in the latter case upon this very subject, so that the interest of the public will be fully protected, and this question will not go down in the records unsolved because of a denial by this Honorable Court of a writ of certiorari in this case, as wrongly inferred by petitioner. The present Petition, therefore, only affects this particular, thrice-tardy petitioner and has no significant effect upon "the public."

XVII.
End of Litigation.

This litigation had been pending five years last October. The appellant has been infringing from the very day the patent was issued in April, 1956.

The patent in suit, like any other utility patent, is only good for 17 years. One-third of the term of this patent has now expired, during all of which time the defendant has continuously infringed it. The delay in this litigation is long and serious and has greatly

damaged the respondent by having a strong competitor producing practically the same material and selling it in the same market over such a long period. One-third of the value of respondent's patent has been greatly undermined by persistent infringement by the petitioner despite the final ruling of validity and infringement by the Court of Appeals for the Ninth Circuit.

As stated by this Honorable Court, it is a salutary rule that there must be an end to litigation, and not litigate the same thing over and over again. See the following inspirational statement from *Toledo Scale Co. v. Computing Scale Co., supra:*

> "We cannot know what the result of the hearing would have been on this issue if tried, because only one side is presented. We are prevented from knowing it by a most salutary rule of law, which, after parties have had a full and fair opportunity to prepare their case, refuses to permit them to drag out litigation by bringing in new evidence which, with due diligence, they ought to have discovered before the hearing. The apparent hardship of particular cases should not and cannot weigh against the application of this sound principle. As Mr. Justice Story remarked in Ocean Ins. Co. v. Fields, 2 Story, 59 Fed. Case No. 10406: 'It is for the public interest and policy to make an end to litigation; or, as was pointedly said by a great jurist, that suits may not be immortal while men are mortal.'"

XVIII.
Conclusion.

It is believed that the present Petition for a Writ of Certiorari should be denied due to the inexcusable delay in being three years late in conducting an alleged post-trial experiment in connection with its theory of a patent that was strongly relied upon at the trial, and where the same activity would have produced the alleged "physical embodiment" in due time to be presented to the jury which tried this case. The only excuse by the petitioner is not that it could not have done the same thing three years before, but that it did not at that time recognize the purported importance of a physical embodiment.

A mistake by the petitioner as to the importance of evidence, which it had available at the time of the trial, is not sufficient ground to grant a new trial or relief from the present judgment, because it is not "newly discovered evidence" nor is it "any other reason" for granting a new trial.

Thus, there are no "special" or "important reasons" for granting a writ of certiorari in this case.

Respectfully submitted,

RICHARD P. SCHULZE,
Attorney for Respondent.

Of Counsel:
C. G. STRATTON,
LOUIS M. WELSH,
ROBERT L. HARRISON,
of Los Angeles, California.

January, 1962.

APPENDIX.

PAGE

A.

Excerpts from Petitioner's "Answering Brief" and "Petition for Rehearing" before the Court of Appeals for the Ninth Circuit 1

B.

Affidavit of Robert L. Harrington..... 4

C.

National Sponge Cushion Co., Inc. v. The Mansfield Tire & Rubber Company, et al., No. 711-61-TC, Complaint for Infringement of United States Letters Patent No. 2,740,739, and Answer thereto..... 6

APPENDIX A.

In both petitioner's "Answering Brief" and in "Petition for Rehearing" before the Court of Appeals for the Ninth Circuit, in this case, petitioner presented the same argument that it is now presenting to the Supreme Court, to wit, that the present patented carpet underlay "must of necessity" and "would of inescapable necessity" be produced by the machine shown and described in patent '316. See the following excerpt from page 10 of said Answering Brief:

> "Having disclosed that the rubber facing may be of blowable sponge rubber and that it is soft enough to gravitate into the channels of the shaping drum, the only conceivable result is that the product of No. 2,480,316, when united with the open mesh fabric thereof without cement, as stated in that patent, *must of necessity* be that the blowable sponge rubber will project into and through the interstices of the open mesh fabric when subject to vulcanization, and that the flexible belt 18 will cause the projections of the sponge through the interstices to be flattened and widened as the rubber expands through the interstices during the flowing, thus providing the key-lock so strongly urged by plaintiff. Plaintiff has merely taken the product shown and described in prior Patent No. 2,480,316 in connection with the disclosure of the process or method, and has stated, in synonymous terms the obvious result of that method in describing and claiming the project of the patent in suit. . . .
>
> "In disclosing in prior patent No. 2,480,316 blowable rubber sponge connected to open mesh fabric

by vulcanization and without cement, Bodle has estopped himself from securing a valid patent on the product since his earlier patent issued over three years prior to the application for the patent in suit. Bodle is hoist by his own petard."

and the following from pages 24-25 of the same brief:

"Had the Exxaminer known of Blair and Bodle No. 2,480,316, he would also have known from that patent that the product illustrated in Fig. 1 thereof, without cement, as set forth in the patent specification, and comprising open-mesh fabric and blowable sponge rubber vulcanized thereto *would of inescapable necessity* comprise sponge rubber having a key-locking engagement with the fabric by reason of projections extending into and through the interstices of the fabric, that the projections would be larger, and that they would be the result of being formed and forced by pressure from a blowing agent. . . . If the blowhole sponge rubber of the patent in suit is forced by pressure of a blowing agent into and through the interstices of the fabric to provide a key-lock, then the identical materials under the identical conditions, i.e., the heat of vulcanization, must result in projections of the sponge under the force and pressure of a blowing agent into and through the interstices of the fabric and provide the key-lock." (Emphasis added.)

The petitioner concluded its said Petition for Rehearing as follows (see p. 17):

"In conclusion it is respectfully submitted that your Honors, for some reason, acquired a mis-

conception of the facts pointed out above which are highly significant and which clearly show that the patent in suit is invalid for the reason that the prior Blair-Bodle patent, not considered by the Patent Office, not only shows lack of patentable invention but that it teaches the manufacture of a product which is a complete anticipation of the patent in suit.

"It is respectfully requested that the finding of invalidity of the Court Below be accepted and adopted by this Court.

Respectfully submitted,

ALLAN D. MOCKABEE,

Attorney for Rubber Corporation of California."

APPENDIX B.

AFFIDAVIT OF ROBERT L. HARRINGTON

State of California,)
) ss.
County of Los Angeles)

ROBERT L. HARRINGTON, of the aforesaid County and State, being first duly sworn on oath deposes and says that he is an attorney at law admitted to practice before the Courts of the State of California and before this Honorable Court.*

That in its "Motion for New Trial Under Rule 59(a); For Relief from Judgment Under Rule 60(b); etc." filed in the Lower Court, whose decision on said Motion is under appeal here, the appellant (defendant below) stated (p. 3):

> "Under Rule 59(a) a new trial may be granted on the ground of newly discovered evidence which has been discovered since trial; which could not have been discovered before trial by the exercise of reasonable diligence; that it is material and will produce a result opposite to that which now prevails, and it is not cumulative, corroborative or collateral."

That said statement was contained in the Affidavit of Allan D. Mockabee dated April 13, 1961, filed in said action entitled "National Sponge Cushion Co., Inc., Plaintiff, vs. Rubber Corporation of California, Defendant," Civil Action No. 20438-TC.

*The United States Court of Appeals for the Ninth Circuit

That the above quotation was used as an argument by the defendant Rubber Corporation of California in support of said Motion.

Further affiant sayeth naught.

s ROBERT L. HARRINGTON

SUBSCRIBED and SWORN TO before me this 17th day of August, 1961.

s VESTA NELSON
a Notary Public in and for the State of California, with principal office in the County of Los Angeles.
My Commission expires Nov. 14, 1964

[NOTARIAL SEAL]

APPENDIX C.

C. G. Stratton
Robert L. Harrington
210 West 7th Street
Los Angeles 14, California
MAdison 5-2116
Attorneys for Plaintiff

In the District Court of the United States, Southern District of California, Central Division.

National Sponge Cushion Co., Inc., Plaintiff, vs. The Mansfield Tire & Rubber Company, a corporation; and Orcco Industries, Inc., a corporation, Defendants. Civil Action No. 711-61-TC.

COMPLAINT FOR INFRINGEMENT OF UNITED STATES LETTERS PATENT NO. 2,740,739

(JURY TRIAL DEMANDED)

Plaintiff complains of defendants and alleges:

I.

That this claim arises under the patent laws of the United States, and more particularly, under Title 35 USC Sec. 281, and that jurisdiction is conferred on this Court by Title 28 USC Sec. 1338(a).

II.

That the plaintiff is a corporation duly organized and existing under the laws of the State of California, and has its office and principal place of business in the City of Los Angeles, County of Los Angeles, State of California.

III.

That on April 3, 1956, United States Letters Patent No. 2,740,739 were duly and legally issued to the above-named plaintiff for CARPET UNDERLAY, and that since that date, plaintiff has been and still is the owner of said patent.

IV.

The plaintiff is informed and believes, and upon information and belief alleges that the defendant The Mansfield Tire & Rubber Company is a corporation duly organized and existing under the laws of the State of Ohio, and has a factory and place of business in the City of Capistrano Beach, County of Orange, State of California.

V.

The plaintiff is informed and believes, and upon information and belief alleges that the defendant Orco Industries, Inc. is a corporation duly organized and existing under the laws of the State of California, and has its office and principal place of business in the City of Los Angeles, County of Los Angeles, State of California.

VI.

That ever since April 3, 1956, the defendant The Mansfield Tire & Rubber Company has been infringing said patent by making, using and selling carpet underlay embodying the novel features disclosed and claimed in said patent, in the Southern District of California and elsewhere.

VII.

That ever since April 3, 1956, the defendant Orco Industries, Inc. has been infringing said patent by using, selling, offering for sale and advertising carpet underlay embodying the novel features disclosed and claimed in said patent, in the Southern District of California and elsewhere.

VIII.

That ever since April 3, 1956, each of the defendants The Mansfield Tire & Rubber Company and Orco Industries, Inc. has been contributing to the infringement of said patent by selling carpet underlay to third parties, and causing, aiding and abetting these third parties to infringe said patent by using or reselling the carpet underlay sold to them.

IX.

That the plaintiff has given written notice to each of the defendants The Mansfield Tire & Rubber Company and Orco Industries, Inc. of the said infringement, but that, despite such written notices, both of the defendants have thereafter wilfully and deliberately continued said infringement of said patent.

X.

That the plaintiff has been greatly damaged, and has suffered loss, because of the infringement and contributory infringement herein complained of, in the sum of Two Hundred Thousand Dollars ($200,000.00).

WHEREFORE, the plaintiff demands of the defendants:

(1) Judgment against the defendants for infringement of said patent:

(2) Damages in the sum of Two Hundred Thousand Dollars ($200,000.00);

(3) An assessment of reasonable attorney's fees and costs herein;

(4) Such other relief as to the Court appears just in the premises.

C. G. STRATTON
ROBERT L. HARRINGTON
Attorneys for Plaintiff
by C. G. Stratton

A jury trial in this case is hereby demanded.

By C. G. Stratton

Lyon & Lyon
Reginald E. Caughey
811 West Seventh Street
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MAdison 4-3901
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The Mansfield Tire & Rubber
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DUnkirk 5-7087
Attorneys for Defendant
Orcco Industries, Inc.

Filed Dec. 4, 1961.

United States District Court, Southern District of California, Central Division.

National Sponge Cushion Co., Inc., Plaintiff vs. The Mansfield Tire & Rubber Company, a corporation; and Orcco Industries, Inc., a corporation, Defendants. Civil Action No. 711-61TC

ANSWER

DEFENDANTS, MANSFIELD TIRE & RUBBER COMPANY, and ORCCO INDUSTRIES, INC., referred to jointly as Defendants, in answer to the Complaint, state as follows:

1. Defendants admit the allegations of paragraph 1 of the Complaint;

2. Defendants are without knowledge or information sufficient to form a belief as to the matters alleged in paragraph 2 of the Complaint and therefore leave Plaintiff to its proof;

3. Defendants admit that on April 3, 1956, United States Letters Patent No. 2,740,739, hereinafter sometimes referred to as said patent, was duly issued but denies that the said patent was legally issued for the reasons more particularly set forth in paragraph 11 hereinafter set forth. Defendants are without knowledge or information sufficient to form a belief as to the other matters alleged in paragraph 3 of the Complaint and therefore leave Plaintiff to its proof;

4. Defendants admit the allegations of paragraph 4 of the Complaint;

5. Defendants admit the allegations of paragraph 5 of the Complaint;

6. Defendants deny the allegations of paragraph 6 of the Complaint;

7. Defendants deny the allegations of paragraph 7 of the Complaint;

8. Defendants deny the allegations of paragraph 8 of the Complaint;

9. Defendants admit that they have received a written notice from Plaintiff of the purported infringe-

ment of said United States Letters Patent No. 2,740,739 but deny that they either singly or jointly have either before or after such written notice willfully and deliberately infringed on said patent;

10. Defendants deny the allegations of paragraph 10 of the Complaint;

11. Defendants in further answer to the Complaint, allege that the said United States Letters Patent No. 2,740,739, or the claims thereof, which would cover or read upon any product or article of manufacture now or heretofore manufactured, used or sold by Defendant Mansfield, or used or sold by Defendant Orco or any customers or anyone associated with Defendants, are invalid, void and unenforceable for the following reasons:

A. The product or article of manufacture forming the subject matter of the claims of said patent is identical with or not patentably distinct from the product or article of manufacture naturally and inherently produced by practicing the method and using the materials and apparatus described in United States Letters Patent No. 2,480,316, in the name of G. W. Blair and V. H. Bodle entitled, "Method of Making Laminated Cushion Material" and issued August 30, 1949, a date more than one year prior to the filing date of the application which resulted in the issuance of said patent No. 2,740,739.

B. The purported novelty of the product or article of manufacture forming the subject matter of the claims of said patent was not the inventive act of the patentees of said patent, but is the natural, inherent, and unpreventable result of following the old and well-known process in the rubber industry of

1. Laying a sheet of coarse meshed fabric onto the top of a sheet of uncured rubber containing a compound which will produce gases when heated and

2. Then heating the uncured rubber

a. To produce a gas internally thereof and expand it into a sponge and

b. Then to cure the rubber in the expanded condition.

C. The purported novelty of the product or article forming the subject matter of the claims, namely, the method of fastening the rubber sheeting to the fabric backing, is the same as has been conventionally practiced by the rubber industry from a date at least prior to one year and in fact, for many years prior to the filing date of the application which issued into said patent.

D. The purported novelty of the product or the article of manufacture of the claims of said patent is not new and useful and therefore does not meet the requirements of 35 U. S. C. 101.

E. The differences or purported novelty between the product or article of manufacture forming the subject matter of the claims of said patent and the prior art are such that the subject matter as a whole would have been obvious at the time the purported invention was made to a person having ordinary skill in the art to which the subject matter pertains, such prior art including the practices and knowledge of the rubber industry and the following patents, and other patents and publications as to which Defendants pray leave to insert herein by amendment or otherwise to notify the Plaintiff as soon as and when full information relative thereto is obtained by the Defendants.

1,271,005	Bartlett	July 2, 1918
562,281	Coyte	June 16, 1896
1,457,826	Egerton	June 5, 1923
1,701,526	Bronson	February 12, 1929
1,766,471	Van Dusen	June 24, 1930
1,826,217	McConoughey	October 6, 1931
1,925,271	Miller	September 5, 1933
2,041,356	Kraft	May 19, 1936
2,075,373	Tomec	March 30, 1937
2,278,733	Peik	April 7, 1942
2,296,408	Todd	September 22, 1942
2,341,979	Cunnington	February 15, 1944
2,480,316	Blair	August 30, 1949
2,563,478	Mason	August 7, 1951
2,625,499	Nebesar	January 13, 1953
2,629,678	Thompson	February 24, 1953
2,642,920	Simon	June 23, 1953
2,703,775	Panagrossi	March 8, 1955

F. On information and belief the alleged invention purported to be patented by said patent was not the joint invention of the three named patentees but if an invention at all was the invention of only one or any two of said named patentees.

G. The purported invention was known or used by others in this country before the alleged invention thereof by the patentees to wit, by the parties specified in this paragraph, and particularly under subparagraph E of this paragraph and by others as to which the Defendants are not now fully advised, but as to which the Defendants pray leave to insert herein by amendment or otherwise to notify the Plaintiff as soon as

and when full information relative thereto is obtained by the Defendants.

H. The alleged invention purported to be patented in said patent was patented or described in printed publications in this and/or a foreign country before the alleged invention thereof as specified under subparagraph E of this paragraph and others as to which the Defendants are not now fully advised, but as to which the Defendants pray leave to insert herein by amendment or otherwise to notify the Plaintiff as soon as and when full information relative thereto is obtained by the Defendants.

I. The alleged invention purported to be patented in said patent was patented or described in a printed publication in this or a foreign country or was in public use or on sale in this country, more than one year prior to the date of the application by said patentee for said patent, as specified under subparagraph E of this paragraph and by others as to which the Defendants are not now fully advised, but as to which the Defendants pray leave to insert herein by amendment or otherwise to notify the Plaintiff as soon as and when full information relative thereto is obtained by the Defendants.

J. The alleged invention purported to be patented in said Letters Patent was described in patents granted on application for patent by others and the said patentees filed in the United States before the alleged invention thereof by the said patentees as specified under subparagraph E of this paragraph and in others as to which the Defendants are not now fully advised, but to which the Defendants pray leave to insert herein by amendment or otherwise to notify the Plaintiff as soon as and

when full information relative thereto is obtained by the Defendants.

WHEREFORE, DEFENDANTS having thus fully answered the Complaint, deny that the Plaintiff is entitled to the relief prayed for in the Complaint, or to any relief, and hence Defendants pray that the Complaint be dismissed with costs and reasonable attorneys' fees to the Defendants.

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